



# UNITED STATES PATENT AND TRADEMARK OFFICE

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CESARI AND MCKENNA, LLP  
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BOSTON, MA 02210

EXAMINER

ELLIS, RICHARD L

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2183

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Please find below and/or attached an Office communication concerning this application or proceeding.



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### Notice of Non-Compliant Amendment (37 CFR 1.121)

The amendment document filed on September 26, 2003 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121, as amended on June 30, 2003 (see 68 *Fed Reg.* 38611, Jun. 30, 2003). In order for the amendment document to be compliant, correction of the following item(s) is required. **Only the corrected section of the non-compliant amendment document must be resubmitted (in its entirety), e.g., the entire "Amendments to the claims" section of applicant's amendment document must be re-submitted.** 37 CFR 1.121(h).

THE FOLLOWING CHECKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☐ 1. Amendments to the specification:
  - ☐ A. Amended paragraph(s) do not include markings.
  - ☐ B. New paragraph(s) should not be underlined.
  - ☐ C. Other: \_\_\_\_\_
- ☐ 2. Abstract:
  - ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
  - ☐ B. Other: \_\_\_\_\_
- ☐ 3. Amendments to the drawings: \_\_\_\_\_
- ☒ 4. Amendments to the claims:
  - ☐ A. A complete listing of all of the claims is not present.
  - ☐ B. The listing of claims does not include the text of all claims (including withdrawn claims).
  - ☒ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified. Claim 19 has been labeled with the status identifier "previously presented" while simultaneously containing insertions and deletions marked with underlining and strikeout. Therefore, it is not clear if applicant intends to amend the claims (in which case the status identifier is incorrect) or if applicant intended not to amend (in which case the underlining and strikeout is incorrect).
  - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
  - ☐ E. Other: \_\_\_\_\_

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP Sec. 714 and the USPTO website at <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/officeflyer.pdf>.

If the non-compliant amendment is a **PRELIMINARY AMENDMENT**, applicant is given ONE MONTH from the mail date of this letter to supply the corrected section which complies with 37 CFR 1.121. Failure to comply with 37 CFR 1.121 will result in non-entry of the preliminary amendment and examination on the merits will commence without consideration of the proposed changes in the preliminary amendment(s). This notice is not an action under 35 U.S.C. 132, and **this ONE MONTH time limit is not extendable.**

If the non-compliant amendment is a reply to a **NON-FINAL OFFICE ACTION** (including a submission for an RCE), and since the amendment appears to be a *bona fide* attempt to be a reply (37 CFR 1.135(c)), applicant is given a TIME PERIOD of ONE MONTH from the mailing of this notice within which to re-submit the corrected section which complies with 37 CFR 1.121 in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD ARE AVAILABLE UNDER 37 CFR 1.136(a).**

If the amendment is a reply to a **FINAL REJECTION**, this form may be an attachment to an Advisory Action. **The period for response to a final rejection continues to run from the date set in the final rejection**, and is not affected by the non-compliant status of the amendment.

RICHARD L. ELLIS  
PRIMARY EXAMINER

<b>REVISED AMENDMENT PRACTICE: 37 CFR 1.121 CHANGED COMPLIANCE IS MANDATORY - Effective Date: July 30, 2003</b>
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70 | All amendments filed on or after the effective date noted above must comply with revised 37 CFR 1.121. See Final Rule: **Changes To Implement Electronic Maintenance of Official Patent Application Records** (68 Fed. Reg. 38611 (June 30, 2003)), posted on the Office's website at: <http://www.uspto.gov/web/patents/ifw/> with related information. The amendment practice set forth in revised 37 CFR 1.121, and described below, replaces the voluntary revised amendment format available to applicants since February 2003. **NOTE: STRICT COMPLIANCE WITH THE REVISED 37 CFR 1.121 IS REQUIRED AS OF THE EFFECTIVE DATE (July 30, 2003).** The Office will notify applicants of amendments that are not accepted because they do not comply with revised 37 CFR 1.121 via a Notice of Non-Compliant Amendment. See MPEP 714.03 (Rev. 1, Feb. 2003). The non-compliant section(s) will have to be corrected and the entire corrected section(s) resubmitted within a set period.

***Bold underlined italic font has been used below to highlight the major differences between the revised 37 CFR 1.121 and the voluntary revised amendment format that applicants could use since February, 2003.***

Note: The amendment practice for reissues and reexamination proceedings, except for drawings, has not changed.

### **REVISED AMENDMENT PRACTICE**

#### **I. Begin each section of an amendment document on a separate sheet:**

Each section of an amendment document (e.g., Specification Amendments, Claim Amendments, Drawing Amendments, and Remarks) must begin on a separate sheet. Starting each separate section on a new page will facilitate the process of separately indexing and scanning each section of an amendment document for placement in an image file wrapper.

#### **II. Two versions of amended part(s) no longer required:**

37 CFR 1.121 has been revised to **no longer require** two versions (a clean version and a marked up version) of each replacement paragraph or section, or amended claim. Note, however, the requirements for a clean version and a marked up version for **substitute specifications** under 37 CFR 1.125 have been retained.

#### **A) Amendments to the claims:**

Each amendment document that includes a change to an existing claim, cancellation of a claim or submission of a new claim, **must include a complete listing** of all claims in the application. After each claim number in the listing, the status must be indicated in a parenthetical expression, and **the text of each pending claim** (with markings to show **current** changes) must be presented. The claims in the listing will replace all prior claims in the application.

- (1) The current status of all of the claims in the application, including any previously canceled, not entered or withdrawn claims, must be given in a parenthetical expression following the claim number using only one of the following seven status identifiers: (original), (currently amended), (canceled), (withdrawn), (new), **(previously presented) and (not entered)**. The text of all pending claims, **including withdrawn claims**, must be submitted each time any claim is amended. Canceled **and not entered** claims must be indicated by only the claim number and status, without presenting the text of the claims.
- (2) The text of all claims **being currently amended** must be presented in the claim listing with markings to indicate the changes that have been made relative to the immediate prior version. The changes in any amended claim must be shown by underlining (for added matter) or strikethrough (for deleted matter) with 2 exceptions: (1) for **deletion of five characters or fewer, double brackets may be used (e.g., [[error]]**; and (2) if **strikethrough cannot be easily perceived (e.g., deletion of the number "4" or certain punctuation marks), double brackets must be used (e.g., [[4]])**. **As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strikethrough, followed by including and underlining the extra text with the desired change (e.g., ~~number 4~~ as number 14 as)**. An accompanying clean version is not required and should not be presented. Only claims of the status "currently amended," and "withdrawn" that are being amended, may include markings.
- (3) The text of pending claims **not being currently amended, including withdrawn claims**, must be presented in the claim listing in clean version, i.e., without any markings. Any claim text presented in clean version will constitute an assertion that it has not been changed relative to the immediate prior version except to omit markings that may have been present in the immediate prior version of the claims.

- (4) A claim being canceled must be listed in the claim listing with the status identifier “canceled”; the text of the claim must not be presented. Providing an instruction to cancel is optional.
- (5) Any claims added by amendment must be presented in the claim listing with the status identifier “(new)”; the text of the claim must not be underlined.
- (6) All of the claims in the claim listing must be presented in ascending numerical order. Consecutive canceled, or not entered, claims may be aggregated into one statement (e.g., Claims 1 – 5 (canceled)).

**Example of listing of claims (use of the word “claim” before the claim number is optional):**

Claims 1-5 (canceled)

Claim 6 (previously presented): A bucket with a handle.

Claim 7 (withdrawn): A handle comprising an elongated wire.

Claim 8 (withdrawn): The handle of claim 7 further comprising a plastic grip.

Claim 9 (currently amended): A bucket with a ~~green~~ blue handle.

Claim 10 (original): The bucket of claim 9 wherein the handle is made of wood.

Claim 11 (canceled)

Claim 12 (not entered)

Claim 13 (new): A bucket with plastic sides and bottom.

**B) Amendments to the specification:**

Amendments to the specification, including the abstract, must be made by presenting a replacement paragraph or section or abstract marked up to show changes made relative to the immediate prior version. An accompanying clean version is not required and should not be presented. Newly added paragraphs or sections, including a new abstract (instead of a replacement abstract), must not be underlined. A replacement or new abstract must be submitted on a separate sheet, 37 CFR 1.72. If a substitute specification is being submitted to incorporate extensive amendments, both a clean version (which will be entered) and a marked up version must be submitted as per 37 CFR 1.125.

The changes in any replacement paragraph or section, or substitute specification must be shown by underlining (for added matter) or strikethrough (for deleted matter) with 2 exceptions: (1) for deletion of five characters or fewer, double brackets may be used (e.g., [[error]]); and (2) if strikethrough cannot be easily perceived (e.g., deletion of the number “4” or certain punctuation marks), double brackets must be used (e.g., [[4]]). As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strikethrough, followed by including and underlining the extra text with the desired change (e.g., number 4 as number 14 as)

**C) Amendments to drawing figures:**

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments, or remarks, section of the amendment, and may be accompanied by a marked-up copy of one or more of the figures being amended, with annotations. Any replacement drawing sheet must be identified in the top margin as “Replacement Sheet” and include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. Any marked-up (annotated) copy showing changes must be labeled “Annotated Marked-up Drawings” and accompany the replacement sheet in the amendment (e.g., as an appendix). The figure or figure number of the amended drawing(s) must not be labeled as “amended.” If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Questions regarding the submission of amendments pursuant to the revised practice set forth in this flyer should be directed to: Elizabeth Dougherty or Gena Jones, Legal Advisors, or Joe Narcavage, Senior Special Projects Examiner, Office of Patent Legal Administration, by e-mail to [patentpractice@uspto.gov](mailto:patentpractice@uspto.gov) or by phone at (703) 305-1616.

on the supply, distribution, or use of energy. It has not been designated by the Administrator of the Office of Information and Regulatory Affairs as a significant energy action. Therefore, it does not require a Statement of Energy Effects under Executive Order 13211.

#### List of Subjects in 33 CFR Part 165

Harbors, Marine safety, Navigation (water), Reporting and record keeping requirements, Security measures, Waterways.

■ For the reasons set out in the preamble, the Coast Guard amends 33 CFR part 165 as follows:

#### PART 165—REGULATED NAVIGATION AREAS AND LIMITED ACCESS AREAS

■ 1. The authority citation for part 165 continues to read as follows:

Authority: 33 U.S.C. 1231; 50 U.S.C. 191; 33 CFR 1.05–1(g), 6.04–1, 6.04–6, and 160.5; Department of Homeland Security Delegation No. 0170.

■ 2. A new temporary § 165.T09–223 is added to read as follows:

##### § 165.T09–223 Safety Zone: Lake Michigan, Chicago, IL.

(a) *Location.* The following area is designated a safety zone: the waters of Lake Michigan within the arc of a circle with a 1000-foot radius with its center in the approximate position of 41°52'07" N, 087°35'65" W. (NAD 1983).

(b) *Effective period.* This section is effective from 9 p.m. (local) until 10 p.m. (local), on July 3, 2003.

(c) *Regulations.* In accordance with the general regulations in § 165.23 of this part, entry into this zone is prohibited unless authorized by the Coast Guard Captain of the Port, Chicago, or the designated Patrol Commander.

Dated: June 12, 2003.

Lynn M. Henderson,  
Commander, U.S. Coast Guard, Acting  
Captain of the Port Chicago.

[FR Doc. 03–16458 Filed 6–27–03; 8:45 am]

BILLING CODE 4910–15–U

#### DEPARTMENT OF COMMERCE

##### Patent and Trademark Office

##### 37 CFR Part 1

[Docket No.: 2003–P–007]

RIN 0651–AB59

##### Changes To Implement Electronic Maintenance of Official Patent Application Records

AGENCY: United States Patent and Trademark Office, Commerce.

**ACTION:** Final rule.

**SUMMARY:** The United States Patent and Trademark Office (Office) is revising the rules of practice in patent cases as part of its 21st Century Strategic Plan to implement beginning-to-end electronic image processing of patent applications. Specifically, the changes adopted in this notice facilitate electronic image data capture and processing, streamline the patent application process, and simplify and clarify the pertinent provisions of the rules of practice.

**DATES:** *Effective Date:* July 30, 2003.

*Applicability date:* The changes apply to any paper filed in the Office on or after July 30, 2003. Further, the revisions to §§ 1.3, 1.14(a) through (d) and (f) through (h), 1.59 and 1.99 apply to all patent applications filed before, on, or after July 30, 2003.

**FOR FURTHER INFORMATION CONTACT:** Jay Lucas (703) 308–6868 or Robert Clarke (703) 305–9177, Senior Legal Advisors, or Robert J. Spar (703) 308–5107, Director, Office of Patent Legal Administration (OPLA), directly by phone. Questions may also be submitted in writing to Mail Stop Comments—Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313–1450; by electronic mail sent to [robert.clarke@uspto.gov](mailto:robert.clarke@uspto.gov); or by facsimile to (703) 872–9411.

**SUPPLEMENTARY INFORMATION:** The Office is increasing the integrity of its internal patent application record maintenance by adopting a new electronic data processing system for the storage and maintenance of all the records associated with patent applications. Because the system is consistent with the data processing system used by the European Patent Office (EPO), it will also improve information exchange among the intellectual property (IP) offices.

The system will use image technology to replace the standard paper processing of patent applications currently used in the Office. The paper components of the patent application file contents (including the specification, oath or declaration, drawings, information disclosure statements, amendments, Office actions, and file jacket notations) of pending applications will be scanned into electronic image files. Thereafter, all processing and examination by all Office personnel will be conducted with the electronic image files, instead of the paper source documents.

The system will affect applicants minimally during the patent application process, because the program affects internal operations and not external communications. Applicants may

continue to send and receive correspondence in paper form, although the Office encourages use of the existing alternative electronic filing system resources for application filings and certain information disclosure statement submissions. The changes to the rules of practice in title 37 of the Code of Federal Regulations (CFR) are designed to improve internal operation by the use of the electronic image format, primarily by easing the requirements upon applicants in amendment practice and information disclosure statement submissions. The electronic nature of patent records will permit their viewing by the public through the Patent Application Information Retrieval (PAIR) system, which has a number of advantages: (1) It provides notice to applicants of certain examination processing activities (e.g., mailing of Office actions); (2) it assures confidence in the integrity of the Office records; (3) it reduces the handling of the records; and (4) it allows parallel processing of the application by various parts of the Office.

The technology and procedures for the new system are similar to those used at the EPO, but adapted to the Office's legal requirements and existing computer systems. The Office announced a prototype program in December of 2002. See *USPTO Announces Prototype of Image Processing*, 1265 *Off. Gaz. Pat. Office* 87 (Dec. 17, 2002). The Office has incorporated the experience and lessons learned from this prototype program into a production system. See *Notification of United States Patent and Trademark Office Patent Application Records being Stored and Processed in Electronic Form*, 1271 *Off. Gaz. Pat. Office* 100 (June 17, 2003).

The electronic format of applications will reduce delays in moving information within the Office and between the Office, the applicant, other IP offices and other parties having authority to view the records. It will also reduce the potential for loss of records and misfiling, provide the capacity for multiple parties to access the records simultaneously, improve the efficiency of the publication process, and set the Office up for subsequent improvements in electronic communication related to applications between the Office, the applicant, and other parties.

It is also anticipated that the system will facilitate the sharing of information between the Office and other IP offices. The Office anticipates that agreements to electronically transmit priority documents to certain other IP offices as well as search results and other

application information will be negotiated shortly. Transmission of priority documents electronically directly to the other IP offices on request of the applicant is anticipated to reduce the overall costs to the applicant and to the other IP offices (which would receive the certified copy in a format that is easily stored and retrieved on demand). In tandem with this effort is a parallel effort to promote the sharing of information (e.g., search results) concerning related applications by the various IP offices in order to reduce duplication of efforts, improve the efficiency and quality of examination efforts, and decrease workload. Thus, it is anticipated that the Office's migration to an electronic environment together with international negotiations will improve the efficiency and work quality of the Office.

### Discussion of Specific Rules

#### Section 1.3

Section 1.3 has been amended to provide that papers presented in violation of the decorum and courtesy requirements will not be entered. The Office is capturing electronic images of all documents (papers) that will be the official records of certain applications. If the Office has captured the image of a paper violating § 1.3 as an electronic sheet(s), the Office will electronically remove the document from the Official file (the collection of documents related to a patent application or patent and which would be in this instance an electronic file) and from the Office computer systems. If the application has not yet been captured as an image file, the paper will not be entered in the Official file (which would in this instance be a paper file). In either event, the Office will provide notice in the Official file that the paper will not be available to the public and send a decision to the applicant notifying the applicant of the non-entry. If the paper is intended as a reply to an Office action, the reply will not be considered a *bona fide* reply under § 1.135(c) and the period set in the prior Office action will continue to run.

Similarly, a paper submitted in violation of § 10.10(b) that is intended as a reply will not be entered in the Official file and will not be treated as an unsigned reply (nor as a signed reply) as is the current practice. Therefore, the reply will not toll the time period set in a prior Office action. The Office will provide notice of the non-entry to the applicant or patent owner.

#### Section 1.9

Section 1.9 has been amended to clarify that the word "paper" and "papers" refer to a document or documents, which may be electronic records or physical paper sheet(s).

#### Section 1.14

Section 1.14 explains that applications for patents are generally preserved in confidence, and sets forth the special circumstances (35 U.S.C. 122(a)) under which a member of the public may have information about, copies of, or access to a patent application. Section 1.14 has been revised to clarify the rule and to expand the rule to provide for electronic files.

Paragraph (a)(1) has been rewritten to list the records that may be made available. The term "file wrapper and contents" has been replaced with the term "file contents" to avoid confusion with the paper (non-electronic) file jacket and its contents. Paragraph (a)(1) rephrases the provisions of former §§ 1.14(c) and (e) to assist the public in understanding what applications may be made available to the public. Accordingly, § 1.14(a)(1), as rewritten, is divided into §§ 1.14(a)(1)(i) through (a)(1)(vii) listing different types of application files and explaining whether any part of the file contents may be made available to the public. For example, § 1.14(a)(1)(iii) explains that copies of published pending applications may be made available to the public, upon written request, and payment of the appropriate fee, and that the original paper file of the pending application that was published as a patent application publication is not available to the public. The explanation for when an application may be made available in § 1.14(a)(1)(iv) rephrases the "referred to" provision of former § 1.14(e)(2) with "identified or relied upon" and adds a definition of "identified" that conforms with current Office policy interpreting "referred to." An application is "referred to" when it is identified by application number or serial number and filing date, first named inventor, title and filing date or other application specific information are provided in the text. In addition, in the new § 1.14(a)(1)(v) where the benefit of a pending application is relied upon pursuant to 35 U.S.C. 119(e), 120, 121 or 365 in certain applications, copies of the application file contents may be made available in the same manner that copies of the application would have been had the application been published as a U.S. patent application publication (§ 1.14(a)(1)(iii)). As a result of this change to § 1.14, if an application

is a continuation of an earlier application, and the Office publishes the continuation as a patent application publication but without an identification of the earlier application in the published document, a copy of the file contents of the earlier-filed application may be made available to the public, upon payment of the required fee for a copy, if the application is still pending. This is because the Office (PALM) records for continuation applications, which are available to the public following publication, will indicate the status as a continuation and information about the earlier application.

Paragraph (a)(2) has been revised to combine and restate former §§ 1.14(a)(1) and (b) which address status information. The application number of any application that claims the benefit of the filing date of a patent or an application that has been published may be obtained from the PAIR system on the Office's Internet Web site at: <http://pair.uspto.gov>.

Section 1.14 is also amended to have a new § 1.14(b), to explain that electronic access may be provided to all or part of certain applications. Following migration to an electronic image file as the Official file of patent applications, access will be provided solely to the electronic Official file and not to the original paper document sheets used to create electronic images within the Official file.

Section 1.14(c) is the same as former § 1.14(d). Paragraph (d) of former § 1.14 has been redesignated as § 1.14(c).

Section 1.14(d) is the same as former § 1.14(f). Paragraph (f) of former § 1.14 has been redesignated as § 1.14(d).

Section 1.14(e) is the same as former § 1.14(g). Paragraph (g) of former § 1.14 has been redesignated as § 1.14(e). On reconsideration, the changes proposed in § 1.14(f)(1) and (2) were not necessary to implement an image file wrapper system. The proposed changes, including the public comments, may be reconsidered in the future.

Section 1.14(f) is the same as former § 1.14(h). Paragraph (h) of former § 1.14 has been redesignated as § 1.14(f).

Section 1.14(g) of § 1.14 corresponds to former § 1.14(i), and is further amended to explain the meaning of the terms "Home Copy," "Search Copy," and "Examination Copy," and by inserting "of a publication" after "English language translation" in § 1.14(g)(2). Section 13204 of Public Law 107-273 made a technical change to the provisional rights provisions of the patent statute as to international applications to clarify that a translation of the international publication, as

opposed to the international application, is required to be filed in order for a patent owner to obtain provisional rights pursuant to 35 U.S.C. 154(d). In view of this change to the statute, the corresponding reference to the translation in § 1.14 is changed to add "a publication of an international patent application" after "English language translation of." In addition, the parenthetical phrase at the end of § 1.14(g)(1), referencing the fee for a copy of an international application file, or a copy of a document in a file, has been changed from a reference to § 1.19(b) rather than § 1.19(b)(2) or § 1.19(b)(3), the fees for the contents of a file or a CD, and the parenthetical phrase at the end of § 1.14(g)(2), referencing the fee for a copy of an English language translation in a file, has been corrected to refer to § 1.19(b)(4), the fee for a document, rather than § 1.19(b)(2) or § 1.19(b)(3).

Section 1.14(h) is the same as former § 1.14(j). Paragraph (j) of former § 1.14 has been redesignated as § 1.14(h).

The changes that had been proposed in 1.14(e) have been postponed pending successful negotiation and implementation of agreements with other IP offices to provide for electronic document exchange. The Office will at that time publish a final rule amending § 1.14 to provide for an applicant to provide consent (if the application is being maintained in confidence under 35 U.S.C. 122(a) and § 1.14) to electronic document exchange of the applications with the IP offices with which the Office has such an agreement.

#### Section 1.17

Section 1.17 has been amended to eliminate the reference to returning information that has been expunged in § 1.17(b) because expunged information need not be returned under § 1.59 as amended.

#### Section 1.19

The proposed changes to § 1.19 to eliminate the required fee for providing a copy of an application as filed to certain other IP offices following an agreement with other IP offices to electronically share such document has been postponed pending successful implementation of such agreements. The Office will at that time publish a final rule amending § 1.19 to eliminate its fee for applicants who consent to electronic document exchange of the applications with the IP offices with which the Office has such an agreement.

#### Section 1.52

Section 1.52 has been amended to clarify the requirement for proper paper

sizes in paper communications submitted to the Office and to set forth the analogous requirements for electronic communications.

The Office plans to capture electronic images of all documents that form the record of patent application examination. These images will form the Official file of the application. See *Notification of United States Patent and Trademark Office Patent Application Records being Stored and Processed in Electronic Form*, 1271 Off. Gaz. Pat. Office at 100. Applicants will have the option of submitting application documents and other communications to the Office on paper, by facsimile transmission, or via the Office's electronic filing system (EFS). The existing requirements for paper and facsimile submissions (as well as the prohibition against filing patent applications by facsimile, see § 1.6(d)(3)) are retained, and the requirements for electronic submissions are added. One newly added requirement for paper submissions requires that the papers not be permanently bound because the papers must be readily separable for scanned entry into the image system. The use of binder clips or standard office staples will generally be acceptable. The detailed requirements for electronic submissions are provided in the Office's EFS documentation (available electronically at <http://www.uspto.gov>) and the proposed amendments direct the affected party's attention to those requirements.

Paragraph (a)(1) of § 1.52 has been amended to clarify that it pertains to paper and facsimile submissions, and that such submissions must not be permanently bound together. Correspondence may include multiple papers each of which may be on either 21.6 cm by 27.9 cm (8½ by 11 inch) or 21.0 cm by 29.7 cm (DIN size A4) paper. For example, a transmittal letter and Information Disclosure Statement (IDS) on 21.6 cm by 27.9 cm (8½ by 11 inch) paper accompanied by copies of cited references on 21.0 cm by 29.7 cm (DIN size A4) paper is permitted.

Paragraph (a)(2) of § 1.52 has been amended to clarify that it pertains to paper and facsimile submissions.

Paragraph (a)(5) of § 1.52 has been amended to clarify that it pertains to paper and facsimile submissions.

Paragraph (a) of § 1.52 has also been amended by adding §§ 1.52(a)(6) and (a)(7) to set forth that papers submitted electronically must comply with the Office's EFS requirements and that failure to comply will result in a requirement for correction.

Paragraphs (b)(3) and (b)(4) of § 1.52 have been amended to clarify that the requirements for the abstract and claims to begin on a separate sheet on physical paper are similarly required to begin on a separate electronic page in an electronic submission.

Paragraph (b)(7) of § 1.52 has been amended to explain the consequences of a failure to provide compliant papers within the set time period. That is, § 1.52(b)(7) provides that compliant papers must be provided within the set time period in order to avoid abandonment of the application in the case of an applicant for patent, termination of proceedings in the case of a patent owner in a reexamination proceeding, or refusal of consideration of the papers in the case of a third party requester in a reexamination proceeding.

#### Section 1.59

Section 1.59 has been amended to eliminate references to returning documents that have been expunged to recognize that, with electronic Official files, there will be nothing to return when a paper is expunged. The Office is capturing electronic images of all documents that form the Official file. Where the image is generated from a physical source document, the originating document may be disposed of once the electronic image accuracy is verified. The paper source document will eventually be destroyed under a United States National Archives and Records Administration (NARA) approved schedule. Therefore, if a document is to be expunged from the record, the only operation that will be required will be removal of the image from the Official file.

Paragraph (a)(1) of § 1.59 has been amended by deleting the phrase "and returned" from the first sentence, and deleting the second sentence.

Paragraph (b) of § 1.59 has been amended by deleting the phrase "and return" from each of the first and second sentences. The Office will continue to provide notice in the Official file that a paper has been expunged and the Office will send a decision to the applicant notifying the applicant that the paper has been expunged.

#### Section 1.71

Section 1.71 has been amended by adding a new § 1.71(f) to require that the first page of a specification commence on a new sheet and to require that no sheet including part of the text of the specification include any other material. Further, the claims, abstract or sequence listing (if any) should not be included

on any sheet including any other part of the specification. A title of the invention if it is provided as a heading on the first page of the specification is considered part of the specification.

#### Section 1.72

Paragraph (b) of § 1.72 has been amended to prohibit the paper presenting the abstract to include any other portions of the application or other material. Presentation of material other than the abstract on the same page as the abstract makes the electronic indexing of the application more difficult. In addition, the last sentence of § 1.72(b) has been removed to eliminate the prohibition on using the abstract to interpret the claims to conform the rule to be consistent with Federal Circuit case law. *See Hill-Rom Co. versus Kinetic Concepts, Inc.*, 209 F.3d 1337, 1341 n.\*, 54 USPQ2d 1437, 1440 n.1 (Fed. Cir. 2000).

#### Section 1.75

Paragraph (h) of § 1.75 has been amended to prohibit a paper presenting claims from including any other portions of the application or other material. Presentation of material other than the claims on the same page as one or more claims makes the electronic indexing of the application more difficult.

#### Section 1.98

Section 1.98 has been amended by adding a new § 1.98(e), which provides that the requirement in § 1.98(a)(2)(i) for a copy of all listed U.S. patents and U.S. patent application publications does not apply to any IDS submitted in compliance with the Office's electronic filing system. Thus, for any IDS submitted to the Office via the Office's EFS, paper copies of U.S. patents and U.S. application publications cited in the IDS will no longer have to be supplied by applicants.

An EFS software upgrade has added an IDS, submitted under the provisions of §§ 1.97 and 1.98, as a type of electronic submission that may be made via the Office's EFS. *See Legal Framework for the Use of the Electronic Filing System*, 1263 Off. Gaz. Pat. Office 60, 61 (Oct. 8, 2002). With the EFS software upgrade, an applicant is able to electronically transmit an IDS with the filing of a new utility patent application, or as a subsequent filing. This EFS software upgrade is NOT usable for third party information disclosure submissions under § 1.99. The IDS submission via EFS is the only electronic substitute for a paper IDS submission contemplated. EFS has been available to the general public for

limited electronic filing since October 2000. *See Electronic Filing System Available to Public*, 1240 Off. Gaz. Pat. Office 45 (Nov. 14, 2000).

Applicants may file an IDS via EFS by: (1) Entering the references' citation information in a fillable electronic form, equivalent to the paper PTO-1449 form (or revised form PTO/SB/08A and 08B) by using EFS software; and (2) transmitting the fillable electronic form data to the Office via EFS. This electronic EFS form currently allows only citations for U.S. patents and U.S. patent application publications. If any references to foreign patent documents or non-patent literature documents or unpublished U.S. applications are to be cited, then applicants will continue to submit those citations on a separate, conventional paper PTO-1449 form (or equivalent form) delivered with a printed copy of each cited foreign patent document, non-patent literature document and unpublished U.S. application via mail, facsimile transmission, or hand delivery. In those instances in which an applicant sends an IDS on the same day by EFS and by conventional delivery, and a fee under § 1.97 is due, only one fee will be due if the applicant informs the Office in the conventional submission that such a submission is associated with an electronic submission on the same day in which the fee was paid.

The EFS software provides a fillable electronic IDS form equivalent to a paper PTO-1449, Information Disclosure Statement form, in which citations for up to fifty U.S. patents and up to fifty U.S. patent application publications may be entered. This EFS fillable form has fields where statements of relevance and where notifications that the documents were cited in a communication from a foreign patent Office in accordance with § 1.97(e) may be given. The EFS upgrade validates the format of data entered into the fillable electronic IDS form and provides the means to specify whether this fillable EFS IDS form is to be linked to an accompanying new application filing or is being filed in a previously filed application, and transmit the XML formatted IDS data on the fillable electronic form to the Office. The EFS software also provides fields to enter required fee payment information under §§ 1.97(c)(2) and (d)(2).

The fillable, EFS IDS form will be entered as a paper (but will actually be part of an electronic database) in the application file contents indicating that it was received on the date the complete transmission containing the form was received in the Office via EFS. This is

the date the Office will refer to in considering compliance with § 1.97.

Examiners will consider the U.S. patents and U.S. application publications cited on an EFS transmitted IDS form provided the remaining requirements of §§ 1.97 and 1.98 are met, by reviewing electronic or printed copies produced from the Office's electronic databases. It will be most important that the cited patent and application publication numbers be accurate and devoid of transcription error. There will be no applicant-provided copies of the disclosed documents in the application file for the examiner to review. Instead, because the Office will electronically retrieve the patents and application publications so identified by those numbers, the examiner will only be able to consider the documents so identified. As a corollary, examiners will only consider what is actually cited. Where, for example, an error is made in transcribing a U.S. patent number, and the examiner, after retrieving the patent associated with the number as entered in the IDS, determines that the patent associated with the number as entered in the IDS is not the correct number, because the inventor's name and issue date entered in the IDS does not match the corresponding data on the patent associated with the patent number entered in the IDS, the examiner will follow the procedure regarding the handling of non-complying information disclosure statements set forth in § 609 III(C)(1) of the *Manual of Patent Examining Procedure* (8th ed. 2001) (Rev. 1, Feb. 2003) (MPEP). The examiner may either initial next to the citation on the listing of references to indicate that the erroneously cited patent has been reviewed or line through the citation as not in compliance with § 1.98.

The only procedure for having such documents considered when an erroneous patent or application publication number is cited in an eIDS will be by citing the correct document identifying number in a subsequent IDS, either paper or electronic, that conforms to the requirements of §§ 1.97 and 1.98, as specified in MPEP § 609 III(C)(1) regarding corrections of the information in non-complying information disclosure statements.

The IDS may be submitted as part of an EFS electronic application filing, or subsequent to an application filing, either in paper or via EFS. The ePAVE program will prompt the filer to associate an IDS file with a new application file and to provide payment information, where either is appropriate. As with the other types of



electronic submissions, ePAVE will validate the format, display it to the filer, prompt for the filer's electronic signature, use the filer's digital certificate (an appropriate digital certificate may be obtained from the Office's Electronic Business Center) to encrypt the whole package, and transmit the submission to the Office. Upon receipt, the Office will send to the filer an electronic "Acknowledgment Receipt," including a server date stamp, a unique server number, the application number, and confirmation of the number of the files received by the Office. If the IDS submission is subsequent to the application filing, the filer will be required to enter both an application number and a confirmation number. A confirmation number is an additional four-digit identifier assigned to an application, and can be found in the upper left-hand corner of the official filing receipt. A filer will be required to have a customer number, obtained from the Office's Electronic Business Center, and an Office provided digital certificate to use EFS as with current practice.

#### Section 1.99

Section 1.99 has been amended to provide that the Office will not enter any explanation of the patents or publications, or any other information (that is not limited to patents or publications) included in a submission. The Office will also not enter a submission that is not in compliance with the requirements of § 1.99. The Office is capturing electronic images of all documents that form the Official file of certain applications and the original paper documents, if stored, will be stored off-site and will not be easily accessible, and if destroyed, will not be available. Therefore, any submission, or part of the submission, that is not in compliance with § 1.99 would not be captured as electronic images and, if such documents have been entered into the Official file, the Office will electronically remove the documents from the Official file.

Paragraph (d) of § 1.99 has been amended by deleting the word "dispose of" and replacing it with "not enter." Paragraph (e) of § 1.99 has been amended by deleting the phrase "returned or discarded" and replacing it with "will not be entered."

#### Section 1.121

The manner of making amendments to the specification, claims and drawings in non-reissue applications has been revised to permit greater navigational control during examination in an image file wrapper environment.

Paragraph (b) continues to provide the manner of making amendments to the specification and further provides that its provisions do not apply to making amendments to the claims, computer listings or sequence listings. Paragraph (b) has been revised to require a particular format of marking to show changes and also to eliminate the requirement to provide a clean copy of any revised paragraph or section.

Paragraph (b)(1) provides the manner of making an amendment to delete, add or replace a paragraph. It also explicitly provides that amendments to section headings or the title of the invention are to be made as if the section heading or title were a paragraph.

Paragraph (b)(1)(i) continues to require that an amendment include an instruction that unambiguously identifies the location, in the specification, of the paragraph to be deleted or replaced, or where a new paragraph is to be added.

Paragraph (b)(1)(ii) provides that any replacement paragraph must include markings to show all changes relative to the immediate prior version of the paragraph. Added subject matter must be shown by underlining the added text. If any paragraph is being marked-up to show added subject matter and at least part of the added subject matter is to be underlined itself following entry, then the subject matter intended to include underlining that is being added may be shown by double underlining that part of the added text. Deleted subject matter must be shown by striking through the deleted text with two exceptions: (1) For deletion of five characters or fewer, double brackets may be used (e.g., [[error]]); and (2) if strike-through cannot be easily perceived (e.g., deletion of the number "4" or certain punctuation marks), double brackets must be used (e.g., [[4]]). As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strike-through, followed by including and underlining the extra text with the desired change. The requirement to provide a clean version of the replacement paragraph has been eliminated. Examples of typical amendments in the revised practice will be available on the Office's Internet Web site (<http://www.uspto.gov>).

Recognizing that some word processing software will automatically generate a vertical line in the margin adjacent marked-up changes, the Office will not object to the inclusion of a vertical line in the margin of amendments to the specification or claims. As an alternative to providing an amendment to the first line of the

specification to make the reference required by § 1.78 to claim the benefit of a prior application, the Office will continue the practice under § 1.76 to accept an application data sheet that includes the required reference in § 1.78 to claim the benefit of a prior application.

Paragraph (b)(1)(iii) provides that when a paragraph is added to the specification, the text of the new paragraph must not be underlined.

Paragraph (b)(1)(iv) provides that the amendment paper must not include a marked-up version of a deleted paragraph. Where applicant has used the optional paragraph numbering system set forth in § 1.52(b)(6), an appropriate instruction to delete a paragraph would be "Please delete paragraph 0016." Applicants may also include the first and/or last few words of a paragraph to uniquely identify the paragraph to be deleted. An appropriate instruction would be "Please delete the paragraph beginning 'Potash may be obtained' on page 16."

Paragraph (b)(2)(i) continues to require that an amendment include an instruction which unambiguously identifies the section heading of the section of the specification being replaced.

Paragraph (b)(2)(ii), like its counterpart paragraph (b)(1)(ii), has been revised to require that any replacement section must include markings to show all changes relative to the immediate prior version of the section. Added subject matter must be shown by underlining the added text. If the replacement section being marked-up to show added subject matter and at least part of the added subject matter is to be underlined itself following entry, then the subject matter intended to include underlining that is being added may be shown by double underlining that part of the added text. Deleted subject matter must be shown by striking through the deleted text with two exceptions: (1) for deletion of five characters or fewer, double brackets may be used (e.g., [[error]]); and (2) if strike-through cannot be easily perceived (e.g., deletion of the number "4" or certain punctuation marks), double brackets must be used (e.g., [[4]]). As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strike-through, followed by including and underlining the extra text with the desired change. Recognizing that some word processing software will automatically generate a vertical line in the margin opposite marked-up changes, the Office will not object to the inclusion of a vertical line

in the margin of amendments to the specification or claims. Paragraph (b)(2)(ii) has also been revised to eliminate the requirement to provide a clean version of the replacement section. Examples of typical amendments in the revised practice will be available on the Office's Internet Web site (<http://www.uspto.gov>).

Amendments to the abstract of the disclosure should be included in that portion of applicant's amendment document which presents amendments to the specification. Where the amendments to the abstract are minor in nature, *i.e.*, purely grammatical in nature or a limited number of additions or deletions of subject matter are presented, the abstract should be provided as a marked-up version using strike-through and underlining as the methods to show all changes relative to the immediate prior version. Where the abstract is being substantially rewritten and the amended abstract bears little or no resemblance to the previously filed version of the abstract, a new (substitute) abstract may be provided in clean form accompanied by an instruction for the cancellation of the previous version of the abstract. The text of the new abstract must not be underlined. It would be counterproductive for applicant to prepare and provide an abstract so riddled with strike-through and underlining that its meaning and language are obscured from view and comprehension. Whether supplying a marked-up version of a previous abstract or a clean form new abstract, the abstract must still comply with § 1.72(b) requirements regarding length and placement of the abstract on a separate sheet of paper.

Paragraph (b)(3) has been rewritten to reflect a concurrent revision to § 1.125. Although the requirement for a clean form, or version without markings, of a replacement paragraph or section of the specification has been eliminated, the Office maintains the need for a clean form and a marked-up version of a substitute specification. Since substitute specifications generally include many changes, the clean version will assist the examiner to view the substitute specification without distractions from the markings. The marked-up version will assist the examiner in readily ascertaining those changes being made and to alert the examiner to the presence of any new matter. Amendment by substitute specification is permissible where, as set forth in § 1.121(b)(3)(i), an instruction to replace the specification is submitted and, as set forth in § 1.121(b)(3)(ii), the substitute specification is provided in compliance

with §§ 1.125(b) and (c). Section 1.125(b) continues to require that a substitute specification be accompanied by a statement that it includes no new matter. Section 1.125(c) now requires that two versions of the substitute specification be provided. One version must be submitted with markings showing all changes (strike-through, or in some cases double brackets, indicating subject matter being deleted and underlining indicating subject matter being added) relative to the immediate prior version of the specification of record. An accompanying clean version (without markings) must also be supplied.

Strike-through and underlining features are available in most, if not all, commercially available word processing systems. Often times these features are located and activated through a "format" menu, which allows the user to create text, which is struck through or underlined, or highlight text already presented. In the latter case, previously presented text may be selected and strike-through or underlining engaged such that the text is marked in the desired fashion. Additionally, some word processing systems offer editorial tools that permit a user to automatically "track changes" made when editing a document. These editorial tools frequently use strike-through as the manner in which to indicate deleted subject matter and underlining as the manner in which to indicate added subject matter. To clearly identify a line or a section of a document in which changes have been made, these editorial tools may place a vertical line in the left or right margin of the document directly adjacent to the line or section of text in which the changes occur. The presence of such vertical lines in the left or right margin of a replacement paragraph or section of the specification or a marked-up version of a substitute specification is acceptable.

Deleted subject matter may also be indicated in some circumstances by double brackets placed at the beginning and the end of the deleted text. Double brackets must be used if the deleted text would not be easily perceived using strike-through. For example, changing "4 corners" to "three corners" should be indicated by "*three* [[4]] corners" rather than "*three*4 corners" (the strike-through being obscured by the horizontal line in the "4"). Double brackets may also be used to indicate the deletion of five or fewer consecutive characters. Alternatively, the use of strike-through and/or underlining to show the deletion and/or addition of punctuation marks or difficult to perceive characters may, in the

replacement paragraph or rewritten claim, encompass portions of text before and after the punctuation marks or characters. Examples of typical amendments in the revised format will be available on the Office's Internet Web site (<http://www.uspto.gov>).

The prior requirement made in §§ 1.121(b)(1)(ii) and (b)(2)(ii) to provide a clean form, or version without markings, of a replacement paragraph or section to the specification has been eliminated.

Paragraph (b)(4) remains unchanged.

New § 1.121(b)(5) has been added to provide that once a paragraph, section, or specification is amended in a first amendment document, re-presentation of the amended material in subsequent amendment documents is not necessary unless it is amended again or a substitute specification is provided.

Paragraphs (c)(1) through (c)(3) have been replaced with revised §§ 1.121(c) and (c)(1) through (c)(5). Paragraph (c) as revised provides for a total rewriting of a claim each time the claim is amended, including markings to show the changes being made relative to the immediate prior version of the claim, except when the claim is being canceled. Section 1.121(c) also requires submitting a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, and the status of each and every claim in every amendment document that includes an amendment to the claims. This listing, if entered, replaces all prior versions of the claims in the application. Inclusion of the claim status is required for each claim in each claim listing and must be indicated in a parenthetical expression following the claim number. The status of all claims in the application, even those previously canceled or withdrawn, must be indicated in the claim listing.

The status of each claim included in the claim listing must be described by one of the following seven defined identifiers in parentheses after the claim number:

(Original): Claim filed with the application

(Currently amended): Claim being amended in the current amendment document

(Canceled): Claim deleted from the application.

(Withdrawn): Claim still in the application, but in a non-elected status.

(Previously presented): Claim added or amended in an earlier amendment document.

(New): Claim being added in the current amendment document.

(Not entered): Claim presented in a previous amendment document but which has either not been entered or the status of entry is unknown to applicant when a subsequent amendment to the claims is filed.

The status identifier "previously presented" must be used in those circumstances where: (1) A claim has been previously presented as "new" in a prior amendment document and entry of the claim is certain; and (2) a claim has been previously presented as "currently amended" in a prior amendment document. "Previously presented" should not be used for a claim which was previously presented in a prior amendment document, most particularly an after final amendment, and entry of the claim was denied or applicant is uncertain at the present time whether or not the claim has been approved for entry. The status of "not entered" should be used for such claims. It is foreseen that the latter described scenario could occur in those situations where a first after final amendment has been filed and applicant desires to file a second after final amendment prior to receiving a notice of allowance or an advisory action notifying the applicant whether or not claims presented or amended in the first after final amendment have been entered. Thus, the status of "not entered" should be used for claims which have not been approved for entry, or if it is not known if they have been approved for entry.

Patent Cooperation Treaty (PCT) amendment procedures (*i.e.*, PCT Articles 19 and 34(2)(b)) are applicable during the international stage of an international application, and thus status identifiers are not to be used during the international stage. During the national stage (pursuant to 35 U.S.C. 371), amendment rules under § 1.121 apply to preliminary and subsequent amendments. When submitting these amendments in national stage, a claim listing is required with status identifiers indicated in a parenthetical expression following the claim number. The status identifier may indicate that claims were "original," "previously presented," or "canceled" based on changes made during the international stage. More specifically, in an amendment under § 1.121 in national stage, the status identifier "original" must be used for claims that had been presented on or by the international filing date and not modified or canceled. The status identifier "previously presented" must be used in any amendment submitted during national stage for all claims added or modified under PCT Articles

19 or 34 in the international stage that were subsequently entered in the national stage. Similarly, the status identifier "canceled" must be used in any amendment submitted during national stage for any claims canceled under an Article 19 or 34 amendment in the international stage that was subsequently entered in the national stage. If the amendment under § 1.121 in the national stage is making a change in a claim, the status identifier "currently amended" must be used for that claim.

The Office will continue the current practice of entering all previously filed unentered after final amendments and amendments filed with a request for continued examination (RCE) under § 1.114, unless applicant instructs otherwise. Absent specific instructions for entry, these amendments will be entered in the order in which they were filed. See MPEP § 706.07(h) (page 700–85). The claim listing in the most recent amendment will be used as the current claim listing. When applicant submits an amendment after final or an amendment with an RCE, the markings in the text of the claims should be made relative to the claims of the last entered amendment (or the original claims if no amendments have been entered). When filing an RCE, applicants are encouraged to present a comprehensive amendment that includes all of the desired changes previously presented in the unentered after final amendments along with specific instructions not to enter the after final amendments.

When claims are added, they must be numbered consecutively beginning with the number next following the highest numbered claim previously presented, whether entered or not. See § 1.126. Therefore, the claim listing in any after final amendment, or amendment filed with an RCE, should include the claim number(s) for any unentered new claims submitted in a previously filed after final amendment, the status identifier should be indicated as (not entered) and the text of such claims must not be presented. Consecutive unentered claims may be aggregated into one line (*e.g.*, claims 20–25 (not entered)) in the claim listing. If applicant wishes to represent the previously submitted but unentered new claims, the claim listing must include the new claims with claim numbers beginning with the number next following the highest numbered claim previously presented. The new claims must include the status identifier "new" and the text of the new claims.

The Office will also continue the current practice of entering unentered after final amendments that the examiner has indicated would be entered upon the filing of an appeal.

Absent specific instructions for entry, these amendments will be entered in the order in which they were filed. The claim listing in the most recent amendment will be used as the current claim listing.

Combining the status identifiers (withdrawn) and (currently amended) into a single status identification, *e.g.*, (withdrawn—currently amended), may be used in those situations where a claim has been previously withdrawn as non-elected but applicant wishes to amend the claim in an effort to rejoin the withdrawn (non-elected) claim with the elected invention. In all other situations only a single status identifier may be used.

As a result of the changes to § 1.121, each amendment document will be self-contained, as it sets forth a complete listing of all claims, including the text of all pending claims, for examination and provides the status of all of the claims in one location in the file.

Paragraph (c)(1) provides for the presentation of the claims in ascending numerical order. This prevents the grouping of claims by status (all "new" claims together, all "currently amended" claims together, etc.), and ensures a complete listing of all claims in numerical order, regardless of status. Consecutive "canceled" or "not entered" claims, however, may be aggregated (*e.g.*, "Claims 1–5 (canceled)"). Further, paragraph (c)(1) requires that any sheet of an amendment paper including part of the text of a claim shall not include material directed to any other part of the amendment or any remarks concerning the claims. In other words, the complete listing of all of the claims must commence on a separate sheet of the amendment document. This requirement facilitates indexing of the application papers.

Paragraph (c)(2) requires that markings be provided in claims to show the addition or deletion of subject matter. Added subject matter must be shown by underlining. If any claim is being marked-up to show added subject matter and at least part of the added subject matter is to be underlined itself following entry, then the subject matter intended to include underlining that is being added may be shown by double underlining that part of the added text. Deleted subject matter must be shown by striking through the deleted text with two exceptions: (1) For deletion of five characters or fewer, double brackets may be used (*e.g.*, [[error]]); and (2) if strike-through cannot be easily perceived (*e.g.*, deletion of the number "4" or certain punctuation marks), double brackets must be used (*e.g.*,

[[4]]). As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strike-through, followed by including and underlining the extra text with the desired change. This section eliminates the previously accepted use of equivalent marking systems. No other methods of markings or comparison (other than underlining, strike-through or double brackets) are permitted. Only claims of the status "currently amended," or "withdrawn" if also being amended, shall include markings showing changes made. Examples of typical amendments in the revised format will be available on the Office's Internet Web site (<http://www.uspto.gov>).

Paragraph (c)(3) requires that the current amendment document also include the submission of a clean version, *i.e.*, without any markings in the presentation of text, of all pending and withdrawn claims not being amended, but being included as part of the claim listing in the current amendment document. The presentation of a clean version in any "original," "previously presented," or "withdrawn" claim constitutes an assertion that it has not been changed relative to the immediate prior version except to omit markings that may have been present in the immediate prior version of the claims of the (current) status of withdrawn or previously presented. This relieves the Office of the burden of cross-reading various versions of the same claim to ensure accuracy of rewritten claims. Any claims added by amendment must be indicated with the status of "new," presented in clean version, and shall not be underlined.

Paragraphs (c)(4)(i) and (ii) set forth when claim text must not be presented and that cancellation of any claim is effected by mere instructions to cancel. Alternatively, identifying the status of a claim in the complete listing of all claims as "canceled" will constitute an instruction to cancel the claim. The text of "canceled" and "not entered" claims must not be presented; and these claims must be indicated as being in the status of "canceled" or "not entered," respectively.

Paragraph (c)(5) requires that a claim canceled in its entirety can only be reinstated if presented as a new claim with a new claim number.

Paragraph (d) requires that any drawing changes be submitted in compliance with § 1.84 on replacement sheets as an attachment to an amendment document. An accompanying detailed explanation of all of the changes should be provided on a separate sheet in the drawing

amendments or remarks section of the amendment document. A marked-up copy of one or more of the figures being amended, with annotations, may also be included to provide further explanation of the changes made. The marked-up version must be labeled as "Annotated marked-up Drawings." Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per § 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. No further drawing submission of the amended drawing figure(s) by applicant would be required, unless applicant is so notified.

In order to bring § 1.121(g) into conformity with earlier changes, "(c)(1)" is changed to "(c) and (c)(1) through (c)(5)."

A new § 1.121(h) has been inserted to require that each section of an amendment (*e.g.*, amendments to the claims, amendments to the specification, replacement drawings, remarks) begin on a separate sheet of the amendment paper.

Previous §§ 1.121(h), (i), and (j) have been redesignated as §§ 1.121(i), (j), and (k), respectively.

#### Section 1.125

Paragraph (b) has been revised to add a cross-reference to § 1.312 to remind applicants that for submissions of substitute specifications filed after the notice of allowance has been mailed and up to the time of payment of the issue fee, entry of the substitute specification is not a matter of right.

Paragraph (c) of § 1.125 has been revised to require the presentation by applicant of both a marked-up version of the specification (using strike-through or in some circumstances double brackets to indicate deleted subject matter and underlining to indicate added subject matter) and a clean

version without markings. Deleted subject matter must be shown by striking through the deleted text or, in some cases, placing double brackets at the beginning and the end of the deleted text. Double brackets must be used if the deleted text would not be easily perceived using strike-through, such as, the deletion of a punctuation mark or a number. Double brackets may also be used to indicate the deletion of five or fewer consecutive characters. Examples of typical amendments in the revised format will be available on the Office's Internet Web site (<http://www.uspto.gov>).

#### Section 1.173

Current § 1.173(b)(3) is being replaced by §§ 1.173(b)(3), (3)(i) and (3)(ii) as a conforming amendment, in order to provide consistency between utility and reissue drawing practice.

#### Section 1.823

Section 1.823 has been amended by revising § 1.823(a)(1) to require that any sheet including a part of a sequence listing not include material other than part of a sequence listing. This change is to facilitate indexing of the specification.

#### Response to Comments

The Office published a notice proposing changes to the rules of practice to implement electronic maintenance of official patent application records. *See Changes to Implement Electronic Maintenance of Official Patent Application Records*, 68 FR 14365 (Mar. 24, 2003), 1269 *Off. Gaz. Pat. Office* 166 (Apr. 22, 2003) (proposed rule). The Office received twenty written comments (from Intellectual Property Organizations, Law Firms, and Patent Practitioners) in response to this notice. Comments generally in support of a change are not discussed. The comments and the Office's responses to those comments follow:

**Comment 1:** A number of comments questioned if the Office, after making the proposed change in § 1.3, would continue its practice of providing notice to an applicant, patent owner or third party requester when a paper submitted by that party constituted a failure of proper decorum and courtesy.

**Response:** The Office will continue to provide written notice that a paper submitted by a party to the Office constitutes a failure of proper decorum and courtesy. Following the mailing of the written notice, the paper will no longer be retained in the public electronic image file wrapper. The paper version will eventually be destroyed

under a NARA approved schedule. The Office has also amended § 1.3 to provide that notice of non-entry will be provided.

*Comment 2:* One comment indicated that there was no reasonable basis for the proposed change to § 1.3.

*Response:* It is noted that following transition to an image file wrapper environment, the physical paper constituting a failure of proper decorum and courtesy will either have been previously physically destroyed or will be in a temporary storage facility arranged by date order of scanning. Therefore, the Office will be unable to provide the document or, if the document is still in temporary storage, would incur unnecessary costs and delays to provide the physical paper document.

*Comment 3:* One comment indicated that the proposed change to § 1.9 to add a new § 1.9 (R) should be revised to indicate that a new § 1.9 "k" has been added.

*Response:* The comment has been adopted. The rule has been revised to add a new § 1.9 "k" rather than a § 1.9 (R).

*Comment 4:* As to § 1.14(a), two responses suggested expanding the applications that are available to the public without a petition for access to also include unpublished pending applications that are either incorporated by reference in certain documents or relied upon under 35 U.S.C. 119(e), 120, 121 or 365 by an application that has issued as a U.S. patent or in an application that has published as a statutory invention registration, or with effect as a U.S. application. One comment stated that since almost ninety percent of pending U.S. applications are now published, there is no sound public policy or unusual Office burden that should prevent public access to these unpublished pending applications, and argued that these unpublished pending applications can be an essential source of prosecution history that is necessary, for example, to interpret the scope of claims in a patent that relies on the unpublished pending application for filing date benefit.

*Response:* The comment that pending applications that are relied upon under 35 U.S.C. 119(e), 120, 121 or 365 should be more readily available to the public has been adopted, but the limited access to applications that are incorporated by reference remains. Accordingly, proposed § 1.14(a)(1)(v) (which address unpublished pending applications) has been separated into §§ 1.14(a)(1)(v) (for benefit situations) and (vi) (for incorporation by reference or otherwise identified situations). A copy of the

application as originally filed, the file contents, or any document in the file of an unpublished pending application that is relied upon in a benefit claim will be available upon written request pursuant to § 1.14(a)(1)(v). A copy of the application as originally filed for an unpublished pending application that is incorporated by reference will also be available upon payment of the required fee pursuant to § 1.14(a)(1)(vi). Thus, these types of pending applications will continue to require payment of a fee for copies, as access to these applications is limited. The Office will continue to require that an order for a copy of the file contents, or any paper in the file, be placed with the Office of Public Records (OPR) in order to reduce the amount of time that the application is removed from the examination process. Of course, pursuant to § 1.14(b), if the Office has an image file wrapper (IFW) and once the public inspection utility is available to the public, the public would be permitted to inspect the IFW at any time, even when the application is in final data capture for issuance of the application as a patent.

*Comment 5:* One comment also requested clarification as to the definition of "referenced." Another comment indicated that there is a defect with § 1.14 in that it does not notify the public that the Office will provide either a copy of or access to a file for an abandoned unpublished application if the application number for that abandoned unpublished application is referenced in a document in the file of a publicly available application, such as in an IDS in the publicly available application. The Office should revise § 1.14 to clarify that point.

*Response:* In the final rule, the term "identified" has been used instead of "referenced" in order to provide greater clarity. For an application to be "identified" there must be a reference to the application in the published patent or patent application document itself. In § 1.14(a)(iv), the following sentence has been added: "An application is considered to have been identified in a document, such as a patent, when the application number or serial number and filing date, first named inventor, title and filing date or other application specific information are provided in the text of the patent, but not when the same identification is made in a paper in the file content of the patent and is not included in the printed patent or application publication." As a result, any application that is identified in a patent whether on the front page of the patent, in the "References Cited" section, incorporated-by-reference in the specification, or relied upon for priority,

or in some other manner, is available to the public. If an application is identified in an amendment to the specification of an application, and that amendment is later canceled, then the application is not identified in the patent document.

Note that if the application was relied upon under 35 U.S.C. 119(e) or 120, but for some reason, the application was not identified in the patent application publication (e.g., the benefit claim was made in a preliminary amendment and preliminary amendments are not reflected in patent application publications (see § 1.215(a))), the application is still available to the public because Office computer records will show the benefit claim.

It is not enough that the application has been referenced somewhere in the file content, such as in an examiner's Office action. An application that is mentioned in an examiner's Office action may be available on petition, but not automatically by operation of the rule. Examiners need to be able to mention copending commonly assigned applications and to distinguish the application that they are examining from other applications of the applicant, and the record needs to be clear as to discussion of other relevant applications, but if such a discussion also had the effect of laying open the related applications, then the Office would continually be subjected to requests to expunge the record of allegedly unnecessary references to other applications.

*Comment 6:* One comment noted that proposed new § 1.14(b) states that "the Office may at its discretion provide access only to an electronic copy of the specification, drawings, and file contents of the application." The comment further noted that the proposed rule does not indicate how the Office will "provide access only to an electronic copy" and requested that the proposed rule be revised to clarify what "access only to an electronic copy" means to apprise practitioners of what they need to do to get that access.

*Response:* The comment has not been adopted. The mechanism by which the Office will provide electronic copies is anticipated to change rapidly over the next five years, and the text of proposed § 1.14(b) was chosen to give the Office flexibility in the mechanism in which electronic access will be provided. At this time, the Office does not limit access for any patent applications to electronic copies, and when the Office does limit such access, the Office will explain how to obtain such access on the Office's Internet Web site as well as in other documents.

*Comment 7:* Several comments indicated approval of proposed new § 1.14(e) to § 1.14. One comment requested that the Office streamline the global patenting process by relieving applicants of the burden of having to place and track orders for certified copies and then ship them around the world by relieving applicants who consent to sharing the electronic file of their applications of the need to request that the Office transmit their application to other IP offices in which they are claiming priority, by deeming a priority claim made in an IP office with which the Office has a bilateral agreement as authorization for the Office to transmit the file to that IP office or provide that office with access to the file.

*Response:* Pending implementation of the system to provide document exchange, the revision to § 1.14(e) has been postponed. Deeming a priority claim made in an IP office with which the Office has a bilateral agreement as an authorization for the Office to transmit a file to that Office and for the Office to electronically obtain the priority document is an excellent suggestion that the Office will explore further. At this time, however, the Office does not consider it advisable to treat a priority claim as being sufficient to permit an office of subsequent filing to "pull" the priority document from the office of first filing. The Office prefers to provide for the office of first filing to "push" the priority document to the office of subsequent filing at the request of the applicant to do so. This is because applicants do sometimes inadvertently provide the wrong application number in their priority claim.

*Comment 8:* Another comment requested that the Office create a process by which the applicant provides express written consent to the sharing of its electronic application with other IP offices as simply as possible by allowing the consent to be incorporated into the Application Transmittal as well as being submitted as a separate paper either at the time the application is filed or subsequent thereto.

*Response:* The proposed changes to § 1.14(e) have been postponed. The comments made will be considered when the proposed change is reconsidered. The Office plans to make consent to share its electronic application as simple as possible. The Office has a strong interest in sharing search results and other information with other IP offices.

*Comment 9:* One comment stated that proposed new § 1.14(e) indicates that the Office may share unpublished applications with other IP offices, if the

applicant consents, and presumed that the Office will implement a procedure wherein the applicant is notified of an intent to share the application with the other IP offices, and then requires the applicant to take some affirmative action after notice by the Office, as is proposed in § 1.14(f)(2) regarding decisions the Director wants to publish for Board proceedings that are not otherwise public.

*Response:* The proposed changes to § 1.14(e) have been postponed. The comments made will be considered when the proposed change is reconsidered.

*Comment 10:* Finally, under § 1.14(f)(2) (as proposed), another comment encouraged the Office to make any action or decision that involves an interpretation of patent laws and regulations that would be of important precedential value available to the public regardless of whether the decision discloses a trade secret or other confidential information. The comment explained that the great majority of applications will be available to the public by virtue of a publication of most applications eighteen months after first filing, and argued that the policy and practice of applications being published represents the rule rather than the exception. In the unique circumstances where an action or decision is considered to have important precedential value, the comment argued that the general rule of transparency to the public should prevail over the interests of confidentiality of an individual application that is not even available to most applicants.

In addition as to § 1.14(f) (as proposed), which indicates that the Office may publish certain decisions of the BPAI, several comments on the proposal stated that the Director has authority for publication of such decisions based upon the Director's authority specified in 35 U.S.C. 122(a) to make "information concerning" patent applications public in "special circumstances as may be determined by the Director." The comments in response to the notice of proposed rule making listed one special circumstance as an opinion concerning an application that claims the benefit of a published application, including a published foreign priority application, but the comments in response to this proposed change argued that there is no logical relationship between foreign priority and a benefit to the public, and that there is no logical reason for the Director to treat a claim to priority of a published foreign application as a "special circumstance." Another public comment stated that there is a public

purpose served by publication of BPAI decisions, even if the BPAI does not think those decisions, as noted in the comments, "involve an interpretation of patent laws or regulations that would be precedential," and argued that the Director should state that any decision of the BPAI concerning a patent application is a special circumstance warranting publication of the decision.

*Response:* On reconsideration, the changes proposed in § 1.14(f)(1) and (2) were not necessary to implement an image file wrapper system. The proposed changes, including the public comments on the proposed changes, may be reconsidered in the future.

*Comment 11:* One comment requested clarification on whether the Office intended to require all pages of a paper submitted to the Office in a particular paper to be the same size (e.g., all either on 21.6 cm by 27.9 cm (8½ by 11 inch) or 21.0 cm by 29.7 cm (DIN size A4) paper) in proposed § 1.52(a)(1).

*Response:* All papers being submitted to the Office should be on either 21.6 cm by 27.9 cm (8½ by 11 inch) or 21.0 cm by 29.7 cm (DIN size A4) paper. Rule 1.52(a)(1) currently requires all papers to be on sheets of paper being the same size. For example, each page of an amendment must be on the same size paper. This rule does not, however, require that all correspondence in an application be on the same size paper. As a result, if a foreign client forwards to the patent practitioner prior art on 21.0 cm by 29.7 cm (DIN size A4) paper, a transmittal letter and form USPTO/SB/08 on 21.6 cm by 27.9 cm (8½ by 11 inch) paper may be submitted together with copies of the cited references on 21.0 cm by 29.7 cm (DIN size A4) paper and be consistent with § 1.52.

*Comment 12:* One comment requested that either the Office change its practice and specifically identify what specific provision or provisions of § 1.52 were not complied with in making a decision of non-compliance or assist applicants in submitting proper papers after a notice has been mailed.

*Response:* The Office did not propose any changes to its practice of treating papers not in compliance with § 1.52. Nevertheless, several of the most common errors are, in fact, described with particular detail in notices of non-compliance mailed by the Office. Other less common errors are more generally described. This represents a balancing of the need to process application papers in a timely manner with the desire to assist applicants. Further, when assistance is timely requested, the Office makes efforts to assist applicants in submitting papers.



**Comment 13:** One comment requested that § 1.52(i) be liberalized to permit single line spacing because the Office would no longer need to hand-enter amendments within the electronic files and because the current requirement creates bulky files for applicants.

**Response:** This request cannot be adopted. First, during the transition to an image file wrapper environment, the Office must continue its current paper-based system for a considerable number of applications. Second, even after the transition is complete, the greater than single line spacing is useful for image processing (e.g., using optical character recognition technology). This is particularly true for text including superscript or subscript font. Further, the change would be inconsistent with PCT Rule 11.9(c) and would therefore be undesirable.

**Comment 14:** One comment suggested that the preamble of § 1.59 be reconsidered. It was suggested that the Office should not, particularly during an evaluation period, destroy original (pre-scanning) paper copies of document to safeguard the usability of its records.

**Response:** The Office plans to store the original paper copies for a period of time while the Office evaluates the effectiveness of its quality control and quality assurance procedures. The original paper copies will eventually be destroyed under a NARA-approved schedule.

**Comment 15:** Several comments questioned if the Office, after making the proposed change in § 1.59, would continue its practice of providing notice to an applicant, patent owner or third party requester when a paper was expunged.

**Response:** The Office will continue to provide written notice when granting a petition for expungement. Following the mailing of the written notice, the expunged paper will no longer be retained in the public electronic image file wrapper. The Office has also amended § 1.59 to provide that notice of non-entry will be provided.

**Comment 16:** One comment requested clarification concerning whether an application's title is considered an "other part" in proposed §§ 1.71 and 1.72 or whether the title should continue to be provided on the first page of the specification.

**Response:** The title of the invention, if presented as part of the specification as a heading on the front page of the specification, is considered to be part of the specification. See § 1.77(b)(1). Therefore, the title may continue to be provided on the first page of the specification.

**Comment 17:** One comment suggested that the Office change its internal practices to require applicant's consent to making most substantive changes to abstracts by revising MPEP § 608.01(b).

**Response:** MPEP § 608.01(b) provides that changes to the abstract at allowance are to be made by examiner's amendment. Procedures for preparing examiner's amendment are set forth in MPEP § 1302.04. Substantive changes to the abstract must be made by formal examiner's amendment with approval from the applicant. Therefore, the current practice and procedures are consistent with the comment.

**Comment 18:** One comment suggested that the Office reconsider its proposal to eliminate the last sentence of current § 1.72 and revised the sentence to read: "In proceedings within the Office, the Abstract shall not be used for interpreting the scope of the claims," so that examiners would not be tempted to rely on the Abstract to displace the "broadest reasonable interpretation" of a claim.

**Response:** The comment is not adopted. The Federal Circuit has indicated that the abstract is a potentially helpful source of intrinsic evidence in determining the scope of the claims. See *Hill-Rom Co.* 209 F.3d at 1341 n.\*, 54 USPQ2d at 1440 n.1 (Fed. Cir. 2000).

**Comment 19:** Several comments indicated that it would be unfair for the Office to reduce, by one day, the time period in § 1.97(c) for submission of an information disclosure statement (IDS).

**Response:** The Office proposed this change to realign when applicants would be entitled to consideration of IDSs in light of the real time access to changes in status information by accessing the Office's computer records via the PAIR. Several comments indicated that this change would unfairly burden honest applicants in order to punish a small number of dishonest ones. In light of the comments, the Office has not gone forward with this proposal. The Office is actively considering a change in PAIR to delay the inclusion of changes in status information in PAIR until the next business day after changes in status as an alternative remedy that would not be overly inclusive.

**Comment 20:** One comment suggested that the Office permit submission of e-IDS statements listing foreign patent documents and non-patent literature.

**Response:** The Office has been investigating how to expand the use of e-IDS to non-U.S. patent documents to allow applicant to submit a broader variety of listings of references and to allow examiners to easily retrieve the

cited references. Unfortunately, the Office resources do not permit expansion at this time.

**Comment 21:** One comment questioned if the Office, after determining that a paper submitted under § 1.99 could not be entered, would notify the party submitting the paper that it was not entered.

**Response:** The Office will continue its practice of not corresponding with third parties following publication of an application under 35 U.S.C. 122(b), since the Office's procedures must not permit third party protests after publication without the express written consent of the applicant. See 35 U.S.C. 122(c).

**Comment 22:** A number of comments suggested that the Office reduce the number of status identifiers required as part of § 1.121(c). Several comments stated that the eleven identifiers described for use by the Office were unnecessarily complex, and having to use such a large number could lead to confusion and errors. Most of the focus in the comments was on the identifiers "(Reinstated—formerly claim #)," "(Previously reinstated)," "(Re-presented —formerly dependent claim #)" and "(Previously re-presented)." Several comments suggested the use of no more than five identifiers, since it was felt a number of the proposed identifiers might be overlapping or redundant.

**Response:** The comments, for the most part, have been adopted by the Office. Paragraph (c) is amended in the final rule to require the use of only the following identifiers: (Original), (New), (Currently amended), (Withdrawn), (Canceled), (Not entered) and (Previously presented), the last of which is inclusive of previously added and previously amended claims.

The use of appropriate identifiers in the image file wrapper environment is designed to inform any user (examiner, technical support staff, applicant, practitioner, etc.) of the current status of each and every claim in the application. Labeling a claim as "new" or "currently amended" serves the desired purpose by providing a focus on what is being added to the claims in the application via the current amendment, relative to the immediate prior version. Additional explanations relating to status identifiers or classification of claims into a particular status can be provided at any time in the "Remarks" section of the amendment document.

Claims presented for the first time in an amendment after final rejection should be classified with the status identifier "new." If an applicant presents claims in an amendment after

final rejection, which may or may not have been entered by the Office prior to the submission of a (subsequent) supplemental amendment, a notice of appeal or an RCE request, the second or subsequent amendment should classify any claims presented for the first time in the second or subsequent amendment as "new." Any claims presented for a second or subsequent time (which were previously not entered) should be classified as "not entered." If an applicant presents new claims in an amendment whose entry status is unknown (at the time of filing of a second or subsequent amendment), and the same and/or additional claims are to be presented in a subsequently filed amendment, claim numbers following the last used numbers of the previously filed paper must be employed. See § 1.126. Even if the earlier amendment is not entered, the claim numbers presented in the subsequent amendment must begin after the last numbered claim of the previously submitted amendment. The Office will make modifications to correct the claim numbering prior to allowance once any unentered papers have been approved for entry.

**Comment 23:** Several comments addressed the status of "withdrawn" claims and the desirability of including the text of these claims in the complete claim listing (set), in order to facilitate the calculation of fees and relieve the burden of searching the entire file to locate and determine claim dependencies, etc. Another comment argued on behalf of presenting the claim text of these claims in order to be able to present amendments so as to have them rejoined with the claim(s) being examined.

**Response:** The Office has adopted the suggestion. Paragraph (c) has been revised to require the inclusion of the text of withdrawn claims in the claim listing (set). Paragraph (c) is amended to reflect this change. If withdrawn claims are being amended, they must still be classified with the status identifier "withdrawn," but may include markings to show changes.

**Comment 24:** One comment proposed that the Office modify the language of the rule to provide for presentation of some text that is to be deleted from the specification in order to assist in determining the exact location of text that is to be canceled.

**Response:** The suggestion made in this comment will be permitted in practice by the Office. There are a number of ways to identify the precise location of subject matter which is to be deleted from the specification, such as, use of paragraph numbers, page number

and line number identification: "paragraph at page 4 beginning with 'The apparatus \* \* \*'." Paragraph (b)(1)(i) of this section provides that "Amendments to the specification may be made by submitting: (i) An instruction, which unambiguously identifies the location \* \* \*." If inclusion of a few words of text is needed to "unambiguously" or uniquely locate the paragraph to be deleted (e.g., due to the lack of line numbering), the use of the first and/or last few words of the paragraph is permitted.

**Comment 25:** One comment included the suggestion that the claim listing not be required to present claims in numerical order, but to permit groupings of claims in other than ascending numerical order. The commenter believes it is more important to an examiner to have the claims presented in groupings that represent a logical order, such as by subject matter relationship.

**Response:** The point raised by this comment has validity only in the original presentation of claims, where applicant can control the groupings of related claims as well as the claim numbering. In amendment practice, however, the re-presentation of claims in a different order, or the addition of new claims in an order other than numerical, would cause confusion in processing, make fee calculations difficult and possibly result in claims being overlooked. There are many other aspects of processing which a patent application undergoes, where strict numerical presentation of claims is essential.

**Comment 26:** A number of comments have been received which oppose the use of strike-through as the only marking system acceptable to indicate deleted subject matter in amendments of the specification and claims. Several of the comments raised the likelihood of confusion as the principal argument against the use of strike-through, where, for example, the numeral "4" is to be deleted, or a punctuation mark is to be changed. Others suggested possible confusion for deletion of formula elements. Another noted the inability of some word processing programs to make strike-through a permanent part of the final document.

**Response:** The Office has decided to modify the mandatory requirement of the use of strike-through to permit the use of double brackets (i.e., [[ ]]) where five or fewer characters are being deleted or where the use of strike-through cannot be easily perceived. Strike-through will still be the required method of indicating or marking text that is to be deleted by the amendment.

Double brackets could be used, for example, when changing "4 corners" to "three corners" in an amendment document, which would normally be perceived with difficulty if only strike-through were required. Double brackets may also be used when deleting five or fewer characters.

**Comment 27:** One comment suggested that the proposed rule (§ 1.121(b)(1)(ii)) provided for underlining with respect to a new paragraph being added to the specification, while the sample amendment (on the Office's Internet Web site) did not include underlining of an added paragraph. This apparent inconsistency could lead to confusion among applicants and practitioners.

**Response:** The addition of § 1.121(b)(1)(iii) to the final rule clarifies the use of markings for added paragraphs in the specification. This section provides that the full text of any added paragraph to the specification is to be presented without underlining.

**Comment 28:** Several comments opposed the requirement of § 1.121(d) that replacement sheets of drawings complying with § 1.84 be submitted in an amendment document. It was felt that applicants might incur an unnecessary expense if the drawings were not approved for entry.

**Response:** The suggestions that the Office not require replacement sheets of drawings which comply with § 1.84 have not been adopted. Since the majority of corrected drawings are accepted without requiring further modification, savings of time and resources would result in the majority of cases if additional processing is thereby eliminated. In order to provide an accompanying explanation of the changes being made, applicants must include explanatory comments in the remarks section of the amendment document. In addition, applicant may, under paragraph (d)(1), provide a marked-up drawing with annotations to show the changes made. The examiner may also require a marked-up drawing under paragraph (d)(2).

**Comment 29:** One comment questioned the current practice of retroactive non-entry of papers in violation of § 10.10(b). The comment also requested that papers violating § 10.10(b) be accepted into the record and serve to toll any time period running against the applicant until after the Office has notified applicant that a paper in the application was submitted in violation of § 10.10(b). The same comment requested that the Office only disapprove entry of papers violating § 10.10(b) that are submitted after the Office has provided a first notice in an



application that papers in violation of § 10.10(b) had been submitted.

**Response:** The Office did not propose to revise § 10.10(b). Therefore, the comment was not germane to the changes to the rules of practice that are currently under consideration. The Office will consider the comment, and may reconsider its current practice or propose revisions to its rules of practice, in the future.

**Comment 30:** One comment requested that the Office explicitly provide for the inclusion of a path, file name, date and time of creation corresponding to the location of an application's specification on applicant's hard drive within the application's specification or within some other document submitted with the application.

**Response:** The Office's current rules of practice permit inclusion of this material within the transmittal letter accompanying a new application filing or an amendment document.

**Comment 31:** One comment suggested that the Office permit or require filing in Adobe "pdf" format, preferably preserving the text portion as searchable text. It was also suggested that the Office consider "freezing" the format of Adobe used in order to prevent increased costs.

**Response:** The Office is exploring the business implications of accepting information submitted in an Adobe "pdf" format, and is assessing the legal, business, and technical issues of permitting applications to be filed in this format.

**Comment 32:** An inquiry concerning data security was received.

**Response:** Efforts to safeguard data security are not germane to this rule making and will be discussed by separate document.

**Comment 33:** One comment inquired how the Office was planning to safeguard against facilitating identity theft when it posts images of application data on line.

**Response:** The image file wrapper of an issued patent or published patent application including any signatures included therein is a public document that the Office intends to make publicly available. The Office plans to make these records available for public inspection over the Internet by October 2004. While the Office is actively considering adopting electronic signatures, there is currently no special efforts to safeguard the signatures included in the image file wrapper of applications that are currently pending or any of the signatures submitted in applications filed after a rule change to permit electronic signatures. It is also noted that image copies of any publicly available patent application or patent

file are already available from a number of private sector vendors. Therefore, the Office's plan to make the image file wrapper of patents and published applications available for public inspection over the Internet does not increase the risk of identity theft.

#### Rule Making Considerations

##### *Administrative Procedure Act*

This notice adopts changes to the rules of practice that facilitate electronic image record management of patent application files to support the beginning-to-end electronic processing of patent applications. The changes are limited to the format for and the manner of making amendments to patent applications, the handling of patent applications and other papers within the Office and the manner of filing information disclosure statements. Accordingly, this final rule involves rules of agency practice and procedure under 5 U.S.C. 553(b)(A). *See Bachow Communications Inc. v. FCC*, 237 F.3d 683, 690 (D.C. Cir. 2001). Accordingly, this final rule may be adopted without prior notice and opportunity for public comment under 5 U.S.C. 553(b) and (c), or thirty-day advance publication under 5 U.S.C. 553(d).

##### *Regulatory Flexibility Act*

As prior notice and an opportunity for public comment are not required pursuant to 5 U.S.C. 553 (or any other law), the analytical requirements of the Regulatory Flexibility Act (5 U.S.C. 601 *et seq.*) are inapplicable. As such, the regulatory flexibility analysis is not required, and none has been provided. *See* 5 U.S.C. 603.

##### *Executive Order 13132*

This rule making does not contain policies with federalism implications sufficient to warrant preparation of a Federalism Assessment under Executive Order 13132 (Aug. 4, 1999).

##### *Executive Order 12866*

This rule making has been determined to be not significant for purposes of Executive Order 12866 (Sept. 30, 1993).

##### *Paperwork Reduction Act*

This rule making involves information collection requirements which are subject to review by the Office of Management and Budget (OMB) under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 *et seq.*). The collections of information involved in this final rule have been reviewed and previously approved by OMB under the following control numbers 0651-0021, 0651-0031, 0651-0032 and 0651-0033. The United States Patent and Trademark

Office is not resubmitting an information collection package to OMB for its review and approval because the changes in this proposed rule would not affect the information collection requirements associated with the information collection under OMB control numbers 0651-0021, 0651-0031, 0651-0032 and 0651-0033.

The title, description and respondent description of each of the information collections is shown below with an estimate of the annual reporting burdens. Included in the estimate is the time for reviewing instructions, gathering and maintaining the data needed, and completing and reviewing the collection of information. The principal impacts of the changes in this proposed rule are to (1) expressly provide for the electronic submission of an information disclosure statement; (2) provide for a slight change in the format of an application being filed in order to accommodate for the scanning and indexing of different sections of the application file; and (3) provide for a change in the manner of making amendments to an application consistent with the Office's efforts to establish a patent electronic image management system.

**OMB Number:** 0651-0021.

**Title:** Patent Cooperation Treaty.

**Form Numbers:** PCT/RO/101, ANNEX/134, ANNEX/144, PTO-1382, PCT/IPEA/401, PCT/IB/328, PTO/SB/61/PCT, PTO/SB/64/PCT.

**Type of Review:** Approved through December of 2003.

**Affected Public:** Individuals or Households, Business or Other For-Profit, Federal Agencies or Employees, Not-for-Profit Institutions, Small Businesses or Organizations, Farms, and State, Local or Tribal Government.

**Estimated Number of Respondents:** 331,407.

**Estimated Time Per Response:** 0.25 (15 minutes) to 4.0 (4 hours).

**Estimated Total Annual Burden Hours:** 401,202 hours.

**Needs and Uses:** The information collected is required by the Patent Cooperation Treaty (PCT). The general purpose of the PCT is to simplify the filing of patent applications on the same invention in different countries. It provides for a centralized filing procedure and a standardized application format.

**OMB Number:** 0651-0031.

**Title:** Patent Processing (Updating).

**Form Numbers:** PTO/SB/08A, PTO/SB/08B, PTO/SB/21-27, PTO/SB/30-32, PTO/SB/35-37, PTO/SB/42-43, PTO/SB/61-64, PTO/SB/67-68, PTO/SB/91-92, PTO/SB/96-97, PTO-2053-A/B, PTO-2054-A/B, PTO-2055-A/B.

*Type of Review:* Currently under review.

*Affected Public:* Individuals or Households, Business or Other For-Profit Institutions, Not-for-Profit Institutions and Federal Government.

*Estimated Number of Respondents:* 2,247,270.

*Estimated Time Per Response:* 1 minute and 48 seconds to 4 hours.

*Estimated Total Annual Burden Hours:* 1,021,822 hours.

*Needs and Uses:* During the processing for an application for a patent, the applicant/agent may be required or desire to submit additional information to the United States Patent and Trademark Office concerning the examination of a specific application. The specific information required or which may be submitted includes: Information Disclosure Statements; Submission of priority documents and Amendments.

*OMB Number:* 0651-0032.

*Title:* Initial Patent Application.

*Form Number:* PTO/SB/01-07, PTO/SB/13PCT, PTO/SB/16-19, PTO/SB/29, PTO/SB/101-110.

*Type of Review:* Currently under review.

*Affected Public:* Individuals or Households, Business or Other For-Profit Institutions, Not-For-Profit Institutions, Farms, Federal Government, and State, Local, or Tribal Governments.

*Estimated Number of Respondents:* 319,350.

*Estimated Time Per Response:* 24 minutes to 10 hours and 45 minutes.

*Estimated Total Annual Burden Hours:* 2,984,360 hours.

*Needs and Uses:* The purpose of this information collection is to permit the Office to determine whether an application meets the criteria set forth in the patent statute and regulations. The standard Fee Transmittal form, New Utility Patent Application Transmittal form, New Design Patent Application Transmittal form, New Plant Patent Application Transmittal form, Declaration, Provisional Application Cover Sheet, and Plant Patent Application Declaration will assist applicants in complying with the requirements of the patent statute and regulations, and will further assist the Office in processing and examination of the application.

*OMB Number:* 0651-0033.

*Title:* Post Allowance and Refiling.

*Form Numbers:* PTO/SB/44, PTO/SB/50-51, PTO/SB/51S, PTO/SB/52-53, PTO/SB/55-58, PTOL-85B.

*Type of Review:* Approved through January of 2004.

*Affected Public:* Individuals or Households, Business or Other For-Profit Institutions, Not-For-Profit Institutions, Farms, State, Local and Tribal Governments, and Federal Government.

*Estimated Number of Respondents:* 205,480.

*Estimated Time Per Response:* 2 minutes to 2 hours.

*Estimated Total Annual Burden Hours:* 63,640 hours.

*Needs and Uses:* This collection of information is required to administer the patent laws pursuant to Title 35, U.S.C., concerning the issuance of patents and related actions including correcting errors in printed patents, refiling of patent applications, requesting reexamination of a patent, and requesting a reissue patent to correct an error in a patent. The affected public includes any individual or institution whose application for a patent has been allowed or who takes action as covered by the applicable rules.

Comments are invited on: (1) Whether the collection of information is necessary for proper performance of the functions of the agency; (2) the accuracy of the agency's estimate of the burden; (3) ways to enhance the quality, utility, and clarity of the information to be collected; and (4) ways to minimize the burden of the collection of information to respondents.

Interested persons are requested to send comments regarding these information collections, including suggestions for reducing this burden, to Robert J. Spar, Director, Office of Patent Legal Administration, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, or to the Office of Information and Regulatory Affairs, OMB, 725 17th Street, NW., Washington, DC 20503, (Attn: PTO Desk Officer).

Notwithstanding any other provision of law, no person is required to respond to nor shall a person be subject to a penalty for failure to comply with a collection of information subject to the requirements of the Paperwork Reduction Act unless that collection of information displays a currently valid OMB control number.

#### List of Subjects in 37 CFR Part 1

Administrative practice and procedure, Courts, Freedom of Information, Inventions and patents, Reporting and recordkeeping requirements, Small Businesses.

■ For the reasons set forth in the preamble, 37 CFR part 1 is amended as follows:

#### PART 1—RULES OF PRACTICE IN PATENT CASES

■ 1. The authority citation for 37 CFR part 1 continues to read as follows:

*Authority:* 35 U.S.C. 2(b)(2).

■ 2. Section 1.3 is revised to read as follows:

#### § 1.3 Business to be conducted with decorum and courtesy.

Applicants and their attorneys or agents are required to conduct their business with the United States Patent and Trademark Office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Director and will not be entered. A notice of the non-entry of the paper will be provided. Complaints against examiners and other employees must be made in correspondence separate from other papers.

■ 3. Section 1.9 is amended by adding paragraph (k) to read as follows:

#### § 1.9 Definitions.

\* \* \* \* \*

(k) Paper as used in this chapter means a document that may exist in electronic form, or in physical form, and therefore does not necessarily imply physical sheets of paper.

■ 4. Section 1.14 is revised to read as follows:

#### § 1.14 Patent applications preserved in confidence.

(a) *Confidentiality of patent application information.* Patent applications that have not been published under 35 U.S.C. 122(b) are generally preserved in confidence pursuant to 35 U.S.C. 122(a). Information concerning the filing, pendency, or subject matter of an application for patent, including status information, and access to the application, will only be given to the public as set forth in § 1.11 or in this section.

(1) Records associated with patent applications (see paragraph (g) for international applications) may be available in the following situations:

(i) *Patented applications and statutory invention registrations.* The file of an application that has issued as a patent or published as a statutory invention registration is available to the public as set forth in § 1.11(a). A copy of the patent application-as-filed, the file contents of the application, or a specific document in the file of such an application may be provided upon request and payment of the appropriate fee set forth in § 1.19(b).

(ii) *Published abandoned applications.* The file of an abandoned

application that has been published as a patent application publication is available to the public as set forth in § 1.11(a). A copy of the application-as-filed, the file contents of the published application, or a specific document in the file of the published application may be provided to any person upon request, and payment of the appropriate fee set forth in § 1.19(b).

(iii) *Published pending applications.* A copy of the application-as-filed, the file contents of the application, or a specific document in the file of a pending application that has been published as a patent application publication may be provided to any person upon request, and payment of the appropriate fee set forth in § 1.19(b). If a redacted copy of the application was used for the patent application publication, the copy of the specification, drawings, and papers may be limited to a redacted copy. The Office will not provide access to the paper file of a pending application that has been published, except as provided in paragraph (c) or (h) of this section.

(iv) *Unpublished abandoned applications (including provisional applications) that are identified or relied upon.* The file contents of an unpublished, abandoned application may be made available to the public if the application is identified in a U.S. patent, a statutory invention registration, a U.S. patent application publication, or an international patent application publication of an international application that was published in accordance with PCT Article 21(2). An application is considered to have been identified in a document, such as a patent, when the application number or serial number and filing date, first named inventor, title and filing date or other application specific information are provided in the text of the patent, but not when the same identification is made in a paper in the file contents of the patent and is not included in the printed patent. Also, the file contents may be made available to the public, upon a written request, if benefit of the abandoned application is claimed under 35 U.S.C. 119(e), 120, 121, or 365 in an application that has issued as a U.S. patent, or has published as a statutory invention registration, a U.S. patent application publication, or an international patent application that was published in accordance with PCT Article 21(2). A copy of the application-as-filed, the file contents of the application, or a specific document in the file of the application may be provided to any person upon written request, and payment of the appropriate fee (§ 1.19(b)).

(v) *Unpublished pending applications (including provisional applications) whose benefit is claimed.* A copy of the file contents of an unpublished pending application may be provided to any person, upon written request and payment of the appropriate fee (§ 1.19(b)), if the benefit of the application is claimed under 35 U.S.C. 119(e), 120, 121, or 365 in an application that has issued as a U.S. patent, an application that has published as a statutory invention registration, a U.S. patent application publication, or an international patent application publication that was published in accordance with PCT Article 21(2). A copy of the application-as-filed, or a specific document in the file of the pending application may also be provided to any person upon written request, and payment of the appropriate fee (§ 1.19(b)). The Office will not provide access to the paper file of a pending application, except as provided in paragraph (c) or (h) of this section.

(vi) *Unpublished pending applications (including provisional applications) that are incorporated by reference or otherwise identified.* A copy of the application as originally filed of an unpublished pending application may be provided to any person, upon written request and payment of the appropriate fee (§ 1.19(b)), if the application is incorporated by reference or otherwise identified in a U.S. patent, a statutory invention registration, a U.S. patent application publication, or an international patent application publication that was published in accordance with PCT Article 21(2). The Office will not provide access to the paper file of a pending application, except as provided in paragraph (c) or (h) of this section.

(vii) *When a petition for access or a power to inspect is required.* Applications that were not published or patented, that are not the subject of a benefit claim under 35 U.S.C. 119(e), 120, 121, or 365 in an application that has issued as a U.S. patent, an application that has published as a statutory invention registration, a U.S. patent application publication, or an international patent application publication that was published in accordance with PCT Article 21(2), or are not identified in a U.S. patent, a statutory invention registration, a U.S. patent application publication, or an international patent application that was published in accordance with PCT Article 21(2), are not available to the public. If an application is identified in the file contents of another application, but not the published patent application or patent itself, a granted petition for

access (see paragraph (h)), or a power to inspect (see paragraph (c)) is necessary to obtain the application, or a copy of the application.

(2) Information concerning a patent application may be communicated to the public if the patent application is identified in paragraphs (a)(1)(i) through (a)(1)(vi) of this section. The information that may be communicated to the public (*i.e.*, status information) includes:

(i) Whether the application is pending, abandoned, or patented;

(ii) Whether the application has been published under 35 U.S.C. 122(b);

(iii) The application "numerical identifier" which may be:

(A) The eight-digit application number (the two-digit series code plus the six-digit serial number); or

(B) The six-digit serial number plus any one of the filing date of the national application, the international filing date, or date of entry into the national stage; and

(iv) Whether another application claims the benefit of the application (*i.e.*, whether there are any applications that claim the benefit of the filing date under 35 U.S.C. 119(e), 120, 121 or 365 of the application), and if there are any such applications, the numerical identifier of the application, the specified relationship between the applications (*e.g.*, continuation), whether the application is pending, abandoned or patented, and whether the application has been published under 35 U.S.C. 122(b).

(b) *Electronic access to an application.* Where a copy of the application papers or access to the application may be made available pursuant to paragraphs (a)(1)(i) through (a)(1)(vi) of this section, the Office may at its discretion provide access to only an electronic copy of the specification, drawings, and file contents of the application.

(c) *Power to inspect a pending or abandoned application.* Access to an application may be provided to any person if the application file is available, and the application contains written authority (*e.g.*, a power to inspect) granting access to such person. The written authority must be signed by:

(1) An applicant;

(2) An attorney or agent of record;

(3) An authorized official of an assignee of record (made of record pursuant to § 3.71 of this chapter); or

(4) A registered attorney or agent named in the papers accompanying the application papers filed under § 1.53 or the national stage documents filed under § 1.495, if an executed oath or

declaration pursuant to § 1.63 or § 1.497 has not been filed.

(d) *Applications reported to Department of Energy.* Applications for patents which appear to disclose, purport to disclose or do disclose inventions or discoveries relating to atomic energy are reported to the Department of Energy, which Department will be given access to the applications. Such reporting does not constitute a determination that the subject matter of each application so reported is in fact useful or is an invention or discovery, or that such application in fact discloses subject matter in categories specified by 42 U.S.C. 2181(c) and (d).

(e) *Decisions by the Director or the Board of Patent Appeals and Interferences.* Any decision by the Director or the Board of Patent Appeals and Interferences which would not otherwise be open to public inspection may be published or made available for public inspection if:

(1) The Director believes the decision involves an interpretation of patent laws or regulations that would be of precedential value; and

(2) The applicant, or a party involved in an interference for which a decision was rendered, is given notice and an opportunity to object in writing within two months on the ground that the decision discloses a trade secret or other confidential information. Any objection must identify the deletions in the text of the decision considered necessary to protect the information, or explain why the entire decision must be withheld from the public to protect such information. An applicant or party will be given time, not less than twenty days, to request reconsideration and seek court review before any portions of a decision are made public under this paragraph over his or her objection.

(f) *Publication pursuant to § 1.47.* Information as to the filing of an application will be published in the *Official Gazette* in accordance with § 1.47(c).

(g) *International applications.* (1) Copies of international application files for international applications which designate the U.S. and which have been published in accordance with PCT Article 21(2), or copies of a document in such application files, will be furnished in accordance with PCT Articles 30 and 38 and PCT Rules 94.2 and 94.3, upon written request including a showing that the publication of the application has occurred and that the U.S. was designated, and upon payment of the appropriate fee (see § 1.19(b)), if:

(i) With respect to the Home Copy (the copy of the international

application kept by the Office in its capacity as the Receiving Office, see PCT Article 12(1)), the international application was filed with the U.S. Receiving Office;

(ii) With respect to the Search Copy (the copy of the international application kept by the Office in its capacity as the International Searching Authority, see PCT Article 12(1)), the U.S. acted as the International Searching Authority; or

(iii) With respect to the Examination Copy (the copy of an international application kept by the Office in its capacity as the International Preliminary Examining Authority), the United States acted as the International Preliminary Examining Authority, an International Preliminary Examination Report has issued, and the United States was elected.

(2) A copy of an English language translation of a publication of an international patent application which has been filed in the United States Patent and Trademark Office pursuant to 35 U.S.C. 154(2)(d)(4) will be furnished upon written request including a showing that the publication of the application in accordance with PCT Article 21(2) has occurred and that the U.S. was designated, and upon payment of the appropriate fee (§ 1.19(b)(4)).

(3) Access to international application files for international applications which designate the U.S. and which have been published in accordance with PCT Article 21(2), or copies of a document in such application files, will be permitted in accordance with PCT Articles 30 and 38 and PCT Rules 94.2 and 94.3, upon written request including a showing that the publication of the application has occurred and that the U.S. was designated.

(4) In accordance with PCT Article 30, copies of an international application-as-filed under paragraph (a) of this section will not be provided prior to the international publication of the application pursuant to PCT Article 21(2).

(5) Access to international application files under paragraphs (a)(1)(i) through (a)(1)(vi) and (h)(3) of this section will not be permitted with respect to the Examination Copy in accordance with PCT Article 38.

(h) *Access or copies in other circumstances.* The Office, either *sua sponte* or on petition, may also provide access or copies of all or part of an application if necessary to carry out an Act of Congress or if warranted by other special circumstances. Any petition by a member of the public seeking access

to, or copies of, all or part of any pending or abandoned application preserved in confidence pursuant to paragraph (a) of this section, or any related papers, must include:

(1) The fee set forth in § 1.17(h); and  
(2) A showing that access to the application is necessary to carry out an Act of Congress or that special circumstances exist which warrant petitioner being granted access to all or part of the application.

■ 5. Section 1.17 is amended by revising paragraph (h) to read as follows:

**§ 1.17 Patent application and reexamination processing fees.**

\* \* \* \* \*

(h) For filing a petition under one of the following sections which refers to this paragraph: \$130.00.

§ 1.12—for access to an assignment record.

§ 1.14—for access to an application.

§ 1.47—for filing by other than all the inventors or a person not the inventor.

§ 1.53(e)—to accord a filing date.

§ 1.59—for expungement of information.

§ 1.84—for accepting color drawings or photographs.

§ 1.91—for entry of a model or exhibit.

§ 1.102—to make an application special.

§ 1.103(a)—to suspend action in an application.

§ 1.138(c)—to expressly abandon an application to avoid publication.

§ 1.182—for decision on a question not specifically provided for.

§ 1.183—to suspend the rules.

§ 1.295—for review of refusal to publish a statutory invention registration.

§ 1.313—to withdraw an application from issue.

§ 1.314—to defer issuance of a patent.

§ 1.377—for review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of a patent.

§ 1.378(e)—for reconsideration of decision on petition refusing to accept delayed payment of maintenance fee in an expired patent.

§ 1.644(e)—for petition in an interference.

§ 1.644(f)—for request for reconsideration of a decision on petition in an interference.

§ 1.666(b)—for access to an interference settlement agreement.

§ 1.666(c)—for late filing of interference settlement agreement.

§ 1.741(b)—to accord a filing date to an application under § 1.740 for extension of a patent term.

§ 5.12—for expedited handling of a foreign filing license.

§ 5.15—for changing the scope of a license.

§ 5.25—for retroactive license.

§ 104.3—for waiver of a rule in Part 104 of this title.

\* \* \* \* \*

■ 6. Section 1.52 is amended by revising paragraphs (a) and (b) to read as follows:

**§ 1.52 Language, paper, writing, margins, compact disc specifications.**

(a) *Papers that are to become a part of the permanent United States Patent and Trademark Office records in the file of a patent application or a reexamination proceeding.*

(1) All papers, other than drawings, that are submitted on paper or by facsimile transmission, and are to become a part of the permanent United States Patent and Trademark Office records in the file of a patent application or reexamination proceeding, must be on sheets of paper that are the same size, not permanently bound together, and:

(i) Flexible, strong, smooth, non-shiny, durable, and white;

(ii) Either 21.0 cm by 29.7 cm (DIN size A4) or 21.6 cm by 27.9 cm (8½ by 11 inches), with each sheet including a top margin of at least 2.0 cm (¾ inch), a left side margin of at least 2.5 cm (1 inch), a right side margin of at least 2.0 cm (¾ inch), and a bottom margin of at least 2.0 cm (¾ inch);

(iii) Written on only one side in portrait orientation;

(iv) Plainly and legibly written either by a typewriter or machine printer in permanent dark ink or its equivalent; and

(v) Presented in a form having sufficient clarity and contrast between the paper and the writing thereon to permit the direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes and electronic capture by use of digital imaging and optical character recognition.

(2) All papers that are submitted on paper or by facsimile transmission and are to become a part of the permanent records of the United States Patent and Trademark Office should have no holes in the sheets as submitted.

(3) The provisions of this paragraph and paragraph (b) of this section do not apply to the pre-printed information on paper forms provided by the Office, or to the copy of the patent submitted on paper in double column format as the specification in a reissue application or request for reexamination.

(4) See § 1.58 for chemical and mathematical formulae and tables, and § 1.84 for drawings.

(5) If papers that are submitted on paper or by facsimile transmission do

not comply with paragraph (a)(1) of this section and are submitted as part of the permanent record, other than the drawings, applicant, or the patent owner, or the requester in a reexamination proceeding, will be notified and given a period of time within which to provide substitute papers that comply with paragraph (a)(1) of this section in order to avoid abandonment of the application in the case of an applicant for patent, termination of proceedings in the case of a patent owner in a reexamination proceeding, or refusal of consideration of the papers in the case of a third party requester in a reexamination proceeding.

(6) Papers that are submitted electronically to the Office must be formatted and transmitted in compliance with the Office's electronic filing system requirements.

(7) If the papers that are submitted electronically to the Office do not comply with paragraph (a)(6) of this section, the applicant, or the patent owner, or the requester in a reexamination proceeding, will be notified and given a period of time within which to provide substitute papers that comply with paragraph (a)(6) of this section in order to avoid abandonment of the application in the case of an applicant for patent, termination of proceedings in the case of a patent owner in a reexamination proceeding, or refusal of consideration of the papers in the case of a third party requester in a reexamination proceeding.

(b) *The application (specification, including the claims, drawings, and oath or declaration) or reexamination proceeding and any amendments or corrections to the application or reexamination proceeding.* (1) The application or proceeding and any amendments or corrections to the application (including any translation submitted pursuant to paragraph (d) of this section) or proceeding, except as provided for in § 1.69 and paragraph (d) of this section, must:

(i) Comply with the requirements of paragraph (a) of this section; and

(ii) Be in the English language or be accompanied by a translation of the application and a translation of any corrections or amendments into the English language together with a statement that the translation is accurate.

(2) The specification (including the abstract and claims) for other than reissue applications and reexamination proceedings, and any amendments for applications (including reissue applications) and reexamination

proceedings to the specification, except as provided for in §§ 1.821 through 1.825, must have:

(i) Lines that are 1½ or double spaced;

(ii) Text written in a nonscript type font (e.g., Arial, Times Roman, or Courier) lettering style having capital letters which are at least 0.21 cm (0.08 inch) high; and

(iii) Only a single column of text.

(3) The claim or claims must commence on a separate physical sheet or electronic page (§ 1.75(h)).

(4) The abstract must commence on a separate physical sheet or electronic page or be submitted as the first page of the patent in a reissue application or reexamination proceeding (§ 1.72(b)).

(5) Other than in a reissue application or reexamination proceeding, the pages of the specification including claims and abstract must be numbered consecutively, starting with 1, the numbers being centrally located above or preferably, below, the text.

(6) Other than in a reissue application or reexamination proceeding, the paragraphs of the specification, other than in the claims or abstract, may be numbered at the time the application is filed, and should be individually and consecutively numbered using Arabic numerals, so as to unambiguously identify each paragraph. The number should consist of at least four numerals enclosed in square brackets, including leading zeros (e.g., [0001]). The numbers and enclosing brackets should appear to the right of the left margin as the first item in each paragraph, before the first word of the paragraph, and should be highlighted in bold. A gap, equivalent to approximately four spaces, should follow the number. Nontext elements (e.g., tables, mathematical or chemical formulae, chemical structures, and sequence data) are considered part of the numbered paragraph around or above the elements, and should not be independently numbered. If a nontext element extends to the left margin, it should not be numbered as a separate and independent paragraph. A list is also treated as part of the paragraph around or above the list, and should not be independently numbered. Paragraph or section headers (titles), whether abutting the left margin or centered on the page, are not considered paragraphs and should not be numbered.

(7) If papers that do not comply with paragraphs (b)(1) through (b)(5) of this section are submitted as part of the application, the applicant, or patent owner, or requester in a reexamination proceeding, will be notified and given a period of time within which to provide substitute papers that comply with

paragraphs (b)(1) through (b)(5) of this section in order to avoid abandonment of the application in the case of an applicant for patent, termination of proceedings in the case of a patent owner in a reexamination proceeding, or refusal of consideration of the papers in the case of a third party requester in a reexamination proceeding.

■ 7. Section 1.59 is revised to read as follows:

**§ 1.59 Expungement of information or copy of papers in application file.**

(a)(1) Information in an application will not be expunged, except as provided in paragraph (b) of this section.

(2) Information forming part of the original disclosure (*i.e.*, written specification including the claims, drawings, and any preliminary amendment specifically incorporated into an executed oath or declaration under §§ 1.63 and 1.175) will not be expunged from the application file.

(b) An applicant may request that the Office expunge information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in § 1.17(h) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

(c) Upon request by an applicant and payment of the fee specified in § 1.19(b), the Office will furnish copies of an application, unless the application has been disposed of (*see* §§ 1.53(e), (f) and (g)). The Office cannot provide or certify copies of an application that has been disposed of.

■ 8. Section 1.71 is amended by adding paragraph (f) to read as follows:

**§ 1.71 Detailed description and specification of the invention.**

(f) The specification must commence on a separate sheet. Each sheet including part of the specification may not include other parts of the application or other information. The claim(s), abstract and sequence listing (if any) should not be included on a sheet including any other part of the application.

■ 9. Section 1.72 is amended by revising paragraph (b) to read as follows:

**§ 1.72 Title and abstract.**

(b) A brief abstract of the technical disclosure in the specification must

commence on a separate sheet, preferably following the claims, under the heading "Abstract" or "Abstract of the Disclosure." The sheet or sheets presenting the abstract may not include other parts of the application or other material. The abstract in an application filed under 35 U.S.C. 111 may not exceed 150 words in length. The purpose of the abstract is to enable the United States Patent and Trademark Office and the public generally to determine quickly from a cursory inspection the nature and gist of the technical disclosure.

■ 10. Section 1.75 is amended by revising paragraph (h) to read as follows:

**§ 1.75 Claim(s).**

(h) The claim or claims must commence on a separate physical sheet or electronic page. Any sheet including a claim or portion of a claim may not contain any other parts of the application or other material.

■ 11. Section 1.98 is amended by adding paragraph (e) to read as follows:

**§ 1.98 Content of information disclosure statement.**

(e) The requirement in paragraph (a)(2)(i) of this section for a copy of all listed U.S. patents and U.S. patent application publications does not apply to any information disclosure statement submitted in compliance with the Office's electronic filing system.

■ 12. Section 1.99 is amended by revising paragraphs (d) and (e) to read as follows:

**§ 1.99 Third-party submission in published application.**

(d) A submission under this section shall not include any explanation of the patents or publications, or any other information. The Office will not enter such explanation or information if included in a submission under this section. A submission under this section is also limited to ten total patents or publications.

(e) A submission under this section must be filed within two months from the date of publication of the application (§ 1.215(a)) or prior to the mailing of a notice of allowance (§ 1.311), whichever is earlier. Any submission under this section not filed within this period is permitted only when the patents or publications could not have been submitted to the Office earlier, and must also be accompanied by the processing fee set forth in § 1.17(i). A submission by a member of

the public to a pending published application that does not comply with the requirements of this section will not be entered.

■ 13. Section 1.121 is revised to read as follows:

**§ 1.121 Manner of making amendments in applications.**

(a) *Amendments in applications, other than reissue applications.* Amendments in applications, other than reissue applications, are made by filing a paper, in compliance with § 1.52, directing that specified amendments be made.

(b) *Specification.* Amendments to the specification, other than the claims, computer listings (§ 1.96) and sequence listings (§ 1.825), must be made by adding, deleting or replacing a paragraph, by replacing a section, or by a substitute specification, in the manner specified in this section.

(1) *Amendment to delete, replace, or add a paragraph.* Amendments to the specification, including amendment to a section heading or the title of the invention which are considered for amendment purposes to be an amendment of a paragraph, must be made by submitting:

(i) An instruction, which unambiguously identifies the location, to delete one or more paragraphs of the specification, replace a paragraph with one or more replacement paragraphs, or add one or more paragraphs;

(ii) The full text of any replacement paragraph with markings to show all the changes relative to the previous version of the paragraph. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived;

(iii) The full text of any added paragraphs without any underlining; and

(iv) The text of a paragraph to be deleted must not be presented with strike-through or placed within double brackets. The instruction to delete may identify a paragraph by its paragraph number or include a few words from the beginning, and end, of the paragraph, if needed for paragraph identification purposes.

(2) *Amendment by replacement section.* If the sections of the specification contain section headings



as provided in § 1.77(b), § 1.154(b), or § 1.163(c), amendments to the specification, other than the claims, may be made by submitting:

(i) A reference to the section heading along with an instruction, which unambiguously identifies the location, to delete that section of the specification and to replace such deleted section with a replacement section; and

(ii) A replacement section with markings to show all changes relative to the previous version of the section. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived.

(3) *Amendment by substitute specification.* The specification, other than the claims, may also be amended by submitting:

(i) An instruction to replace the specification; and

(ii) A substitute specification in compliance with §§ 1.125(b) and (c).

(4) *Reinstatement of previously deleted paragraph or section.* A previously deleted paragraph or section may be reinstated only by a subsequent amendment adding the previously deleted paragraph or section.

(5) *Presentation in subsequent amendment document.* Once a paragraph or section is amended in a first amendment document, the paragraph or section shall not be re-presented in a subsequent amendment document unless it is amended again or a substitute specification is provided.

(c) *Claims.* Amendments to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled),

(Withdrawn), (Previously presented), (New), and (Not entered).

(1) *Claim listing.* All of the claims presented in a claim listing shall be presented in ascending numerical order. Consecutive claims having the same status of "canceled" or "not entered" may be aggregated into one statement (e.g., Claims 1–5 (canceled)). The claim listing shall commence on a separate sheet of the amendment document and the sheet(s) that contain the text of any part of the claims shall not contain any other part of the amendment.

(2) *When claim text with markings is required.* All claims being currently amended in an amendment paper shall be presented in the claim listing, indicate a status of "currently amended," and be submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claims. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. Only claims having the status of "currently amended," or "withdrawn" if also being amended, shall include markings. If a withdrawn claim is currently amended, its status in the claim listing may be identified as "withdrawn—currently amended."

(3) *When claim text in clean version is required.* The text of all pending claims not being currently amended shall be presented in the claim listing in clean version, i.e., without any markings in the presentation of text. The presentation of a clean version of any claim having the status of "original," "withdrawn" or "previously presented" will constitute an assertion that it has not been changed relative to the immediate prior version, except to omit markings that may have been present in the immediate prior version of the claims of the status of "withdrawn" or "previously presented." Any claim added by amendment must be indicated with the status of "new" and presented in clean version, i.e., without any underlining.

(4) *When claim text shall not be presented; canceling a claim.*

(i) No claim text shall be presented for any claim in the claim listing with the status of "canceled" or "not entered."

(ii) Cancellation of a claim shall be effected by an instruction to cancel a particular claim number. Identifying the

status of a claim in the claim listing as "canceled" will constitute an instruction to cancel the claim.

(5) *Reinstatement of previously canceled claim.* A claim which was previously canceled may be reinstated only by adding the claim as a "new" claim with a new claim number.

(d) *Drawings.* One or more application drawings shall be amended in the following manner: Any changes to an application drawing must be in compliance with § 1.84 and must be submitted on a replacement sheet of drawings which shall be an attachment to the amendment document and, in the header, labeled "Replacement Sheet." Any replacement sheet of drawings shall include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is amended. All changes to the drawing(s) shall be explained, in detail, in either the drawing amendment or remarks section of the amendment paper.

(1) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be included. The marked-up copy must be clearly labeled as "Annotated Marked-up Drawings" and must be presented in the amendment or remarks section that explains the change to the drawings.

(2) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, must be provided when required by the examiner.

(e) *Disclosure consistency.* The disclosure must be amended, when required by the Office, to correct inaccuracies of description and definition, and to secure substantial correspondence between the claims, the remainder of the specification, and the drawings.

(f) *No new matter.* No amendment may introduce new matter into the disclosure of an application.

(g) *Exception for examiner's amendments.* Changes to the specification, including the claims, of an application made by the Office in an examiner's amendment may be made by specific instructions to insert or delete subject matter set forth in the examiner's amendment by identifying the precise point in the specification or the claim(s) where the insertion or deletion is to be made. Compliance with paragraphs (b)(1), (b)(2), or (c) of this section is not required.

(h) *Amendment sections.* Each section of an amendment document (e.g., amendment to the claims, amendment to the specification, replacement drawings, and remarks) must begin on a separate sheet.

(i) *Amendments in reissue applications.* Any amendment to the description and claims in reissue applications must be made in accordance with § 1.173.

(j) *Amendments in reexamination proceedings.* Any proposed amendment to the description and claims in patents involved in reexamination proceedings must be made in accordance with § 1.530.

(k) *Amendments in provisional applications.* Amendments in provisional applications are not usually made. If an amendment is made to a provisional application, however, it must comply with the provisions of this section. Any amendments to a provisional application shall be placed in the provisional application file but may not be entered.

■ 14. Section 1.125 is amended by revising paragraphs (b) and (c) to read as follows:

**§ 1.125 Substitute specification.**

(b) Subject to § 1.312, a substitute specification, excluding the claims, may be filed at any point up to payment of the issue fee if it is accompanied by a statement that the substitute specification includes no new matter.

(c) A substitute specification submitted under this section must be submitted with markings showing all the changes relative to the immediate prior version of the specification of record. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. An accompanying clean version (without markings) must also be supplied. Numbering the paragraphs of the specification of record is not considered a change that must be shown pursuant to this paragraph.

■ 15. Section 1.173 is amended by revising paragraph (b)(3) to read as follows:

**§ 1.173 Reissue specification, drawings and amendments.**

(b) *Drawings.* One or more patent drawings shall be amended in the following manner: Any changes to a patent drawing must be submitted as a replacement sheet of drawings which

shall be an attachment to the amendment document. Any replacement sheet of drawings must be in compliance with § 1.84 and shall include all of the figures appearing on the original version of the sheet, even if only one figure is amended. Amended figures must be identified as "Amended," and any added figure must be identified as "New." In the event that a figure is canceled, the figure must be surrounded by brackets and identified as "Canceled." All changes to the drawing(s) shall be explained, in detail, beginning on a separate sheet accompanying the papers including the amendment to the drawings.

(i) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be included. The marked-up copy must be clearly labeled as "Annotated Marked-up Drawings" and must be presented in the amendment or remarks section that explains the change to the drawings.

(ii) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, must be provided when required by the examiner.

■ 16. Section 1.823 is amended by revising paragraph (a)(1) to read as follows:

**§ 1.823 Requirements for nucleotide and/or amino acid sequences as part of the application.**

(a)(1) If the "Sequence Listing" required by § 1.821(c) is submitted on paper: The "Sequence Listing," setting forth the nucleotide and/or amino acid sequence and associated information in accordance with paragraph (b) of this section, must begin on a new page and must be titled "Sequence Listing." The pages of the "Sequence Listing" preferably should be numbered independently of the numbering of the remainder of the application. Each page of the "Sequence Listing" shall contain no more than 66 lines and each line shall contain no more than 72 characters. The sheet or sheets presenting a sequence listing may not include material other than part of the sequence listing. A fixed-width font should be used exclusively throughout the "Sequence Listing."

Dated: June 24, 2003.

James E. Rogan,  
Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

[FR Doc. 03-16437 Filed 6-27-03; 8:45 am]

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**LIBRARY OF CONGRESS**

**Copyright Office**

**37 CFR Part 202**

[Docket No. RM 2003-2]

**Architectural Works**

**AGENCY:** Copyright Office, Library of Congress.

**ACTION:** Final rule; technical amendment.

**SUMMARY:** This document makes non-substantive, technical amendments to Copyright Office regulations.

**EFFECTIVE DATE:** June 30, 2003.

**FOR FURTHER INFORMATION CONTACT:** Kent Dunlap, Principal Legal Advisor or Sandra L. Jones, Writer-Editor, Copyright GC/I&R, PO Box 70400, Southwest Station, Washington, DC 20024. Telephone: (202) 707-8380. Telefax: (202) 707-8366.

**SUPPLEMENTARY INFORMATION:** The Copyright Office has reviewed its regulations and makes technical amendments to 37 CFR part 202. In 1990, the Architectural Works Copyright Protection Act amended 17 U.S.C. 101 to add the definition for "architectural work." The Act also exempts from copyright registration architectural works embodied in unpublished plans or drawings created before December 1, 1990, if the works remained unconstructed on December 31, 2002. Regulations pertaining to registration of architectural works are found at 37 CFR 202.11, and paragraph (d) of that section covers works excluded from protection. The time for unpublished works created before December 1, 1990, to become constructed has now expired. The technical amendments are intended to reflect the exclusion and to clarify that the full title of the amending legislation is the Architectural Works Copyright Protection Act, title VII of the Judicial Improvements Act of 1990, Public Law 101-650, 104 Stat. 5089, 5133.

**List of Subjects in 37 CFR Part 202**

Claims, Copyright.

**Final Rule**

■ For the reasons set forth in the preamble, 37 CFR part 202 is amended as follows:

**PART 202—REGISTRATION OF CLAIMS TO COPYRIGHT**

■ 1. The authority citation for Part 202 continues to read as follows:

Authority: 17 U.S.C. 408, 702.

■ 2. Amend § 202.11 by adding "the Architectural Works Copyright